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May 7, 2001

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Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

Re: Application Serial No.: 09/086,857
Appellant: David T. Frederick, et al.
Title: System For Tracking And Dispensing
Medical Items From Environmentally
Controlled Storage Area
Docket No.: D-1093

Sir:

Please find enclosed, in triplicate, Appellant's Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192 in response to the Office Action dated April 9, 2001 for filing in the above case.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Supplemental Appeal Brief, and any other fee due, to Deposit Account 04-1077.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Board of Patent Appeals and Interferences, Commissioner for Patents, Washington, D.C. 20231 this 7th day of May 2001.

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D-1093

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: David T. Frederick, et al.)	
)	
Serial No.: 09/086,857)	Art Unit 3651
)	
Filed: May 29, 1998)	Patent Examiner:
)	Michael E. Butler
Title: System For Tracking And Dispensing)	
Medical Items From Environmentally)	
Controlled Storage Area)	

Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington, D.C. 20231

**SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. §
1.192, in triplicate, concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter. Nevertheless, a claim 45 rejection may be related to Appeal A992631, as noted in the Advisory Action dated November 7, 2000.

STATUS OF CLAIMS

Claims 1-47 are pending in the Application.

Claims 4-23 and 27-44 have been withdrawn from consideration. Claims 1-3, 24-26, and 45-47 have been rejected on art.

Claims 1, 3, 24-25, and 47 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne et al. ("Lavigne"). It is noted that the rejection of claim 45 pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne was overcome by the Declaration as indicated in the Advisory Action ("Advisory") dated November 7, 2000 and confirmed in the Notification of non-compliance ("Notification") dated April 9, 2001.

Claims 1 and 24 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson, Jr. et al. 5,520,450 ("Colson '450").

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson 5,562,232 ("Pearson '232").

Claim 46 was rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Higham et al. '456 ("Higham"). It is noted that the rejection of claim 45 pursuant to 35 U.S.C. § 102(e) as being anticipated by Higham was overcome by the Declaration as indicated in the Advisory dated November 7, 2000 and confirmed in the Notification dated April 9, 2001.

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Colson, Jr. et al. 5,346,297 ("Colson '297").

Claims 1-3 and 24-26 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne.

Claims 46-47 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham. It is noted that the rejection of claim 45 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham was overcome by the Declaration as indicated in the Advisory dated November 7, 2000 and confirmed in the Notification dated April 9, 2001.

Claims 45-46 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '297.

Claims 1, 3, 24-26, and 47 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten et al. ("Aten"). It is noted that the rejection of claim 45 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten was overcome by the Declaration as indicated in the Advisory dated November 7, 2000 and confirmed in the Notification dated April 9, 2001.

Claims 1-3 and 24-25 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Lavigne.

Claims 45-47 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Blechl et al. ("Blechl") in view of Weinberger.

Claim 45-47 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '297 in view of Lavigne.

These rejections were the only rejections presented in the Office Action ("Action"), which was a Final rejection dated August 16, 2000. Appellants appeal each claim rejection, inclusive.

STATUS OF AMENDMENTS

A final rejection was made August 16, 2000. An amendment and a Declaration were filed (September 27, 2000) by Appellants and were entered by the Office after the final rejection. The after final amendment and the Declaration were effective in overcoming some of the rejections presented in the Action, as discussed in more detail hereinafter. Appellants' remarks in the amendment filed September 27, 2000 in the support of the patentability of the claims are herein incorporated by reference as if fully rewritten herein.

Furthermore, a Petition for Withdrawal of a Restriction Requirement was filed by Appellants on October 10, 2000. As of the writing of this Supplemental Brief, Appellants had not yet received a response by the Office in regard to their Petition. Appellants reserve all rights

regarding the Office's response to the Petition, including the filing of a Second Supplemental Appeal Brief.

Additionally, a Petition for Withdrawal of Holding of Noncompliance with 37 C.F.R. § 1.192(c) has been filed. Appellants reserve all rights regarding the Office's response to this Petition.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary embodiment of the invention is directed to a system for providing medical items. The system may be used in dispensing and tracking an inventory of medical items stored in refrigerated or other environmentally controlled storage. The medical items may be used to treat patients in a hospital, clinic, or other healthcare setting. An overview of the system is shown schematically in Figure 13.

The system may include a computer (84) which is in operative connection with a data store (85). The data store includes user data representative of a plurality of authorized users. The data store also includes item data representative of a plurality of medical items, and location data representative of storage locations in which medical items are stored. A user interface may be in operative connection with the computer. A plurality of user interfaces are provided in this exemplary embodiment by data terminals (76, 98, 102) each of which include at least one input device such as a touch screen (78) or a card reader (80.)

The system may include a housing for storing medical items, such as a refrigerator (450), with a door (454). The door controls access to an interior area of the refrigerator. The interior area includes a storage location for at least one medical item. A lock module (452) may be attached to the refrigerator. The lock module may be in operative connection with the computer. The lock module may operate in response to at least one signal from the computer to change the condition of the lock module from a locked to an unlocked condition.

In response to a user inputting identification data through the input device, which identification data corresponds to that of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the input device. The computer is operative responsive to the input of the item indicia, corresponding to a medical item stored in the interior area, to provide a signal changing the lock module to the unlocked condition. This enables the door to be opened and the medical item in the storage location to be accessed by the authorized user.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1, 3, 24-25, and 47 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Lavigne.
- 2). Whether Appellants' claims 1 and 24 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '450.

- 3). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Pearson '232.
- 4). Whether Appellants' claim 46 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by Higham.
- 5). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '297.
- 6). Whether Appellants' claims 1-3 and 24-26 are unpatentable under 35 U.S.C. § 103(a) over Lavigne.
- 7). Whether Appellants' claims 46-47 are unpatentable under 35 U.S.C. § 103(a) over Higham.
- 8). Whether Appellants' claims 45-46 are unpatentable under 35 U.S.C. § 103(a) over Colson '297.
- 9). Whether Appellants' claims 1, 3, 24-26, and 47 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Aten.
- 10). Whether Appellants' claims 1-3 and 24-25 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Lavigne.
- 11). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Blechl in view of Weinberger.
- 12). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Colson '297 in view of Lavigne.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Each of Appellant's claims 1-3, 24-26, and 45-47 recite at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claim.

Every claim recites additional features of the invention which patentably distinguishes the claim over every other pending claim.

The pending claims include three independent claims (claims 1, 24, and 45). Claims 2-3 depend from claim 1. Claims 25-26 depend from claim 24. Claims 46-47 depend from claim 45.

The claims involved in this appeal are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102(b) requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102(b) requires in a single prior art disclosure, each and every element of the claimed invention in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie obviousness*, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The Lavigne Reference

Lavigne discloses a carrier for holding and transporting medical items. It is designed to be carried by a medical technician or other person and to allow them to track their activity in removing medical items from the carrier. The enclosure of Lavigne includes an opening (49) with a hinged door (21) which can be moved to cover or uncover the opening (Col. 4, line 65-Col. 5, line 2). Within the enclosure is a drawer (41). The drawer is used to hold controlled

substances. To open the drawer the operator must insert a key into a key lock (42) (Col. 4, lines 41-45).

A carrier includes a controller (79) which monitors the temperature of drugs inside the carrier to be sure that temperature sensitive drugs therein are maintained within their proper temperature range. The controller also operates to record temperature conditions, as well as information concerning the identity of the person having custody of the carrier and events such as the opening of the door to access the medications in the carrier (Col. 7, lines 53-Col. 8, line 3; Col. 9, lines 6-16). In this way activities by the person in possession of the carrier as well as temperature events are recorded over a period of time.

In operation of the device of Lavigne, when an operator takes control of the carrier the operator inserts a data key into a reader (73). This data is stored to indicate the person who has possession of the carrier (Col. 14, lines 20-27). When the person in control of the carrier wishes to administer a drug, they can open the door (21), remove the desired drug from the carrier and administer the drug to the patient. The operator also records the administration of the drug by entering a code into memory (Col. 14, lines 34-43).

The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) to hold it in a closed position (Col. 11, lines 37-43). This alerts the user to the fact that the drugs in the carrier may have been subject to spoilage due to an out of temperature condition. However a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the

medications even when there has been an out of temperature condition (Col. 12, line 64-Col. 13, line 2). Thus, the door (21) which controls access to the medical items in the carrier is always open and accessible except when the door is locked due to the occurrence of an out of temperature condition.

The Colson '450 Reference

Colson '450 discloses a cabinet system for holding items therein. Colson has a cabinet (1) with dividers which form cavities. One such subcavity (19) includes a computer (21). The computer is described as including a keyboard (23) and optionally a display means, a mouse device, and an output device such as a printer.

One of the cavities in the cabinet includes a refrigerator (101) for holding medicines which require lower storage temperatures. The various compartments, including the compartment holding the refrigerator are covered by doors (25). The doors can be opened to access the cavities. Each of the doors has associated therewith a locking/unlocking means (37). The locking means includes a solenoid to control the unlocking thereof.

When a user wishes to access items in a cavity behind one of the doors, the user inputs to the computer keyboard (23) information concerning the particular patient and information as to the person entering the data. The computer then causes electrical impulses to be issued that travel to a particular electric solenoid to unlock a particular door and permit access to the interior area of the cabinet behind the unlocked door (Col. 5, lines 17-27).

The Pearson '232 Reference

The reference to Pearson '232 is directed to an apparatus for dispensing medication. The apparatus includes a movable cart (2). The cart includes containers (8) and drawers (10) for holding medications. A suction tube (12), which is handled and operated by a nurse, is used to dispense pills and tablets from the containers (8). The nurse may also manually dispense other medication items (e.g., cream, syringe) from a drawer (10). A computer (14) has an input device such as a keyboard. The computer controls locking of the containers (8) and drawers (10), and monitors operation of the suction tube (12). After medications are loaded into the dispenser, the computer controls access to the individual compartments. The computer may correlate the time and a patient's identity to the dosages of each pill appropriate for that patient at that time in accordance with medication orders.

A nurse may input patient information and physician orders into the computer. The computer then compiles a list of medications needed for a selected period of time. A pharmacist reviews the list and loads the proper quantities of medications into the proper containers and drawers. After the pharmacist confirms to the computer that each medication has been properly loaded, then the cart is ready to be used by a nurse to dispense medications to multiple patients.

During dispenser operations the cart may be rolled to several different patient locations. A nurse enters a password to be authorized to use the medication dispenser. The nurse also inputs patient identifying information. The computer unlocks each appropriate container (8) or drawer (10) which holds medication which that particular patient is scheduled to receive at that time. A signal light (22) for each unlocked container (8) or drawer (10) may be changed to

green, making it easy for the nurse to identify the proper medication compartment. If the medication is in one of the containers (8), then the nurse uses the suction tube (12) to withdraw the medication. If the medication is in one of the drawers (10), then the nurse manually withdraws the needed item.

The Higham Reference

The reference to Higham is directed to a device and method for providing access to items to be dispensed. The device includes a dispenser unit (28). The dispenser unit includes an enclosure with a plurality of drawers (32) slidably disposed with a frame (34). The drawers are provided with receptacles (36) for holding items. A row of buttons (30) is common to the drawers. As shown in Figure 2 the six buttons (30) correspond to the six receptacles (36) in each drawer (32). Each drawer has a sensor (40) for sensing when the drawer has been pulled out from the frame (34). The sensors (40) and buttons (30) are connected to a processor. When a particular drawer (32) (e.g., Figure 2, drawer number 6) is opened, the associated sensor (40) sends a signal to the processor indicating access to that particular drawer (32). The processor then sends a signal to set the buttons (30) to correspond to the receptacles (36) of that particular withdrawn drawer (32). An item is manually placed into or removed from a particular receptacle (36) (e.g., Figure 2, receptacle number 2 in drawer number 6) of the withdrawn drawer (32). The button (30) having the same identification symbol (38) (e.g., the number 2) as the accessed receptacle (36) is manually touched to record the action in the processor. Inventory is maintained by using the associated buttons (30). Particularly note col. 11, lines 3-41.

The Colson '297 Reference

The reference to Colson '297 is directed to an auxiliary storage and dispensing unit. The unit is for use in connection with a supply and medication dispenser station. In operation, information concerning the needed patient item and the entering party, inputted into a keyboard (65) results in a cabinet door (19) being unlocked (Col. 4, lines 39-53). Lamps (109) are located in the interior of the cabinet (3). The electric lighting provides illumination to help a user locate stored items (Col. 6, lines 57-68).

The Aten Reference

The reference to Aten is directed to a controlled dispensing device for use by a drug therapist. A field unit is loaded with medication containers in a predetermined sequence. A program of dosing times is stored in a memory of the field unit. The field unit permits dispensing of containers only in accordance with the predefined schedule.

The Blechl Reference

The reference to Blechl is directed to a drug dispenser device (10). As shown in Figure 1, the dispenser device includes a drawer (28) which provides access to the dispensed medicines. When a user designates a type and quantity of desired medications into the input unit (248) of the control device (300), the medications drop from their cartridges (90) into the drawer (28). The input unit may include a user interface screen (30) having touch sensitive features in

communication with a microprocessing means (26). The top of the device (10) is provided with a medication access door (40) permitting a designated individual to stock the device.

As shown in Figure 2, the device (10) includes a medication storage area. A printed circuit board (50) has apertures (52, 54) allowing free fall of drug containers to the drawer (28). The board (50) includes female electrical connectors (56). Figures 3, 4, and 11 show a dispenser (60) made to be inserted into the medication storage area. Offset from the bottom of the dispenser (60) is a support lip (76) which rests against the printed circuit board (50) to support the dispenser (60). Extending downward from the support lip (76) is a male electrical connector (78) adapted to connect with a female electrical connector (56). A solenoid (68) is provided on the exterior of the dispenser housing (62). The solenoid (68) includes a piston (70) which is operatively connected to rotating linkage (72) which is contained on a pivot rod (74). The pivot rod (74) is secured to an arm (82) having a stepped portion (84). Actuation of the solenoid (68) causes rotation of pivot rod (74). Note Figures 10, 15, 17, and 18.

Figures 5-9 show a cartridge (90) for insertion into the dispenser (60). The cartridge (90) is sized to slide into the interior space (64) of the dispenser (60). Stacked medication containers (108) are contained in the interior storage space (102) of the cartridge (90). A retaining member (110) prevents the medication containers (108) from falling out the open bottom (100) of the cartridge (90).

Upon insertion of the cartridge (90) into the dispenser (60), the user removes the retaining member (110) allowing free fall of the medication containers (108) to a dispensing platform (86) of the dispenser (60). The dispensing platform (86) has an aperture (88). Upon actuation of the

solenoid (68), the stepped portion (84) urges the medication container (108) resting on the dispensing platform (86) out the aperture (88) where gravity induces it to fall to the drawer (28).

The Weinberger Reference

The reference to Weinberger is directed to a programmable medication dispensing system. The system is used by self-administering patients such as home-care patients. The system includes a prescribing data entry station for use by a physician. The physician operates the data entry station to store prescription information in a portable prescribing module. The system also includes a dispensing data entry station for use by a pharmacist. The pharmacist stores dispensing information in a portable dispensing data storage module. The system includes a medication dispenser which accepts the portable modules. The dispenser operates in response to the information in the dispensing data storage module to remind the patient to take their medications and to make the medications available to the patient. The information stored in the prescribing module is used to instruct the patient on use of medication in the dispenser in accordance with the information input by the physician.

Lavigne, Colson '450, Pearson '232, and Higham, Do Not Constitute Prior Art

The present application is a continuation-in-part (CIP) application of application 08/927,593 filed September 11, 1997. Application 08/927,593 is a CIP application of application 08/361,783 (now Patent 5,790,409) filed December 16, 1994. In addition, numerous elements of pending claims are disclosed in earlier applications from which this Application claims priority,

including Application Serial Number 08/009,055 filed January 25, 1993 (now U.S. Patent 5,404,384) and Serial Number 08/186,285 filed January 25, 1994 (now U.S. Patent 5,533,079).

Appellants submitted a Declaration on September 27, 2000. The Declaration was entered and considered by the Office. The Declaration and attached documentation established that the invention claimed in at least present claims 24 and 45 was reduced to practice in this country prior to March 7, 1994.

It is further noted in light of MPEP § 715.02 that “Even if applicant’s 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant’s 37 CFR 1.131 evidence, prior to the effective date of the references. Such evidence is sufficient because applicant’s possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art.” Accordingly, Appellants respectfully submit that even if the Declaration and attached documentation were not fully commensurate with the rejected claims, the Office still must consider whether Appellants had reduced to practice a novel system which would have rendered the claimed invention (claims 24 and 45) obvious to one of ordinary skill in the art.

It is noted that the Action in paragraph 18 has alleged a feature of new matter as being the “lock module mounted to the ‘exterior’ surface of the housing” (claim 24). However, as discussed above in accordance with MPEP § 715.02, even if the Declaration and attached documentation were not exactly commensurate with claim 24, the Office still must take into

consideration whether Appellants still had reduced to practice a novel system which would have rendered the claimed invention of claim 24 obvious to one of ordinary skill in the art. It is respectfully submitted that the record indicates that the Office itself considers this feature to be obvious to one of ordinary skill in the art. Evidence of this fact is demonstrated by the Action's own effort to render this feature as obvious in the Action's 35 U.S.C. § 103(a) type rejections of claim 24. (Contrarily, if this feature is not obvious, then the Action's 35 U.S.C. § 103(a) type rejections of claim 24 are moot.)

In conclusion, the Declaration and attached documentation effectively swore back to a date prior to March 7, 1994 for at least present claims 24 and 45. Thus, a date prior to March 7, 1994 is the critical date of at least claims 24 and 45.

Claim 45 is reproduced below to show that the recited subject matter has support in Patent 5,790,409. Claim 24 is similar in scope to claim 45. The claim 45 is reproduced having referenced column and line locations corresponding to Patent 5,790,409 inserted therein. Of course, it should be understood that these referenced locations are for discussion purposes only and that the claim is not limited to the embodiment presented. No unnecessary limitations are to be implied from using such references in the present claim for purposes of illustration. The present invention is not limited to the details, features and relationships shown or described in the prior Patent 5,790,409 or the pending application.

Claim 45 A system for providing medical items comprising:

(Col. 3, lines 20-63) a computer (84; 86), wherein the computer is in operative connection with the data store (Col. 3, lines 22-26; Col. 10, lines 31-34), wherein the data store includes user data representative of a plurality of authorized users (Col. 3, lines 22-26; Col. 8, lines 43-58), item data representative of a plurality of medical items (Col. 3, lines 22-26; Col. 4, lines 8-12; Col. 9, lines 20-36), and location data (Col. 3, lines 22-26; Col. 9, lines 20-36) representative of storage locations in which the medical items are stored;

a user interface (Col. 3, lines 20-22; Col. 8, lines 15-17) in operative connection with the computer, wherein the interface includes at least one input device (Col. 9, lines 42-47; Col. 8, lines 15-24);

(Col. 16, lines 11-33) a housing (Col. 16, lines 17-19), wherein a storage location for at least one medical item is located in an interior area of the housing, the housing including a door (96), wherein access to the storage location is controlled by opening and closing the door (Col. 16, lines 19-23);

a lock (Col. 16, lines 19-23) in operative connection with the housing, wherein the lock is in operative connection with the computer (Col. 16, lines 53-57, 24-33), and wherein the lock is operative responsive to at least one signal from the computer to change the lock from a locked to an unlocked condition (Col. 16,

lines 53-57), wherein in the locked condition the door is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting through the at least one input device identification data (Col. 8, lines 28-42) corresponding to data for an authorized user stored in the data store (Col. 8, lines 28-42), the computer enables the user to input item indicia corresponding to a medical item through the at least one input device (Col. 17, lines 1-12, 49-54; Col. 8, lines 9-17; Col. 16, lines 46-57), and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition (Col. 16, lines 26-30, 54-57; Col. 17, lines 9-13).

As clearly shown by Appellants, each recited feature in claim 45 (and also claim 24) has basis in Patent 5,790,409, from which the present application claims priority. Furthermore, in view of the accepted Declaration, claim 45 (and claim 24) is entitled to a critical date prior to March 7, 1994.

Lavigne Does Not Constitute Prior Art

Lavigne was filed March 2, 1995. However, Appellants' entitled date (prior to March 7, 1994) is earlier than March 2, 1995. Thus, Lavigne cannot constitute prior art against at least claims 24 and 45. Furthermore, the Office has admitted (in the Advisory Action) that "The

affidavit was effective in overcoming the rejections to claim 45 in view of Lavigne & Lavigne/Aten.”

Colson '450 Does Not Constitute Prior Art

Colson '450 was granted on a CIP application of Colson '297. Colson '297 does not include the pertinent features for which Colson '450 was applied in the Action. Specifically and by way of example and without limitation, Colson '297 (explained in more detail hereinafter) does not disclose or suggest a data store including “data representative of a plurality of authorized users”, or “data representative of a plurality of medical items”, or “data representative of storage locations in which the medical items are stored”, or the input of “identification data corresponding to data for an authorized user stored in the data store”, or enabling a “user to input item indicia” in response thereto. It is respectfully submitted that Colson '297 does not disclose these features. Thus, even if it were possible for Colson '450 to have included the recited features, Colson '450 is not entitled to the filing date of Colson '297 for the recited features.

Hence, for purposes of this appeal, Colson '450 has a filing date limited to August 2, 1994. However, Appellants’ entitled date (prior to March 7, 1994) is earlier than August 2, 1994. Thus, Colson '450 cannot constitute prior art against at least claims 24 and 45.

Furthermore, because Colson '297 does not disclose or suggest the recited features, it is respectfully submitted that Appellants do not need to swear behind the Colson '297 reference in order to establish patentability of the present invention.

Pearson '232 Does Not Constitute Prior Art

The actual filing date of the Pearson '232 reference is February 12, 1996. Pearson '232 claims priority to several earlier applications. Pearson '232 is a continuation of Pearson 5,490,610 (filed April 13, 1995), which is a continuation of abandoned Application Serial Number 206,877 (filed March 7, 1994), which is a CIP of Pearson '029.

However, it is respectfully submitted that Pearson '232 can claim a priority date no earlier than March 7, 1994, which is the filing date of Application Serial Number 206,877. This is because Application 206,877 is a CIP of Pearson 029. Thus, March 7, 1994 is the date in which Application 206,877 (and Pearson '232) relied on new subject matter (not found in Pearson '029) to support the invention therein. This new matter was critical to the issued Pearson '232. Thus, at best, March 7, 1994 is the critical reference date of Pearson '232.

As evidenced by the lack of a Pearson '029 rejection in the Action, Pearson '029 does not disclose the features that were considered pertinent to the pending claims. Specifically and by way of example and without limitation, Pearson '029 does not disclose or suggest a "data store" including "data representative of a plurality of authorized users", or the input of "identification data corresponding to data for an authorized user stored in the data store", or enabling a "user to input item indicia" in response thereto. There is no indication that Pearson '029 includes a "data store" in the manner recited. Pearson '029 does not disclose determining that the user is an authorized user. There is no indication that Pearson '029 is concerned with input of identification data corresponding to data for an authorized user stored in the data store. In Pearson '029 the nurse (user) merely inputs the patient's ID into the keyboard (Col. 5, lines 16-17) during operation to obtain the medication. It is respectfully submitted that Pearson '029 does

not disclose the recited features. Thus, even if it were possible for Pearson '232 to have included the recited features, Pearson '232 is not entitled to the filing date of Pearson '029 for these recited features.

For purposes of this appeal, Pearson '232 at best has a filing date limited to March 7, 1994. However, Appellants' entitled date (prior to March 7, 1994) is earlier than March 7, 1994. Thus, Pearson '232 cannot constitute prior art against at least claims 24 and 45.

Higham Does Not Constitute Prior Art

Higham was filed July 14, 1994. However, Appellants' entitled date (prior to March 7, 1994) is earlier than July 14, 1994. Thus, Higham cannot constitute prior art against at least claims 24 and 45. Furthermore, the Office has admitted (in the Advisory Action) that the Declaration was "effective in overcoming the 102(e) based anticipatory and obviousness rejections of claim 45 as evidenced by Higham." The Notification confirms that claim 45 is patentable over Higham. It follows that claims 46-47, which depend on claim 45, are also patentable over Higham.

Numerous Rejections Are Overcome By Appellants' Prior Invention

Appellants have established that the subject matter of at least claims 24 and 45 was reduced to practice in this country prior to at least March 7, 1994. As a result many of the rejections (involving at least claims 24 and 45) presented in the Action which are based on 35 U.S.C. § 102 are obviated. The paragraphs referenced below correspond to those presented in the Action. These obviated rejections (involving claims 24 and 45) include:

Rejections based on Lavigne (Action Paragraph 5)

Rejections based on Colson '450 (Paragraph 6)

Rejections based on Pearson '232 (Paragraph 7)

Rejections based on Higham (Paragraph 8)

Furthermore, the Patent Office Rules also provide that when an obviousness rejection is based on one or more references and the applicant swears behind one reference, the obviousness rejection is overcome. MPEP § 715.02. As a result the following rejections (involving at least claims 24 and 45) in the Action pursuant to 35 U.S.C. § 103 are obviated because Appellants have sworn behind at least one of the references. These obviated rejections are as follows:

Lavigne alone (Paragraph 11)

Higham alone (Paragraph 12)

Lavigne and Aten (Paragraph 14)

Colson '450 in view of Lavigne (Paragraph 15)

Colson '297 and Lavigne (Paragraph 17)

Since many of the applied references do not constitute prior art in relation to at least claims 24 and 45, it is respectfully submitted that the only questions remaining in this appeal are:

- 1). Whether Appellants' claims 1 and 3 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Lavigne.
- 2). Whether Appellants' claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '450.

- 3). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '297.
- 4). Whether Appellants' claims 1-3 are unpatentable under 35 U.S.C. § 103(a) over Lavigne.
- 5). Whether Appellants' claims 45-46 are unpatentable under 35 U.S.C. § 103(a) over Colson '297.
- 6). Whether Appellants' claims 1 and 3 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Aten.
- 7). Whether Appellants' claims 1-3 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Lavigne.
- 8). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Blechl in view of Weinberger.

Furthermore, it is noted that the Advisory Action indicated, and the Notification confirmed, that the 35 U.S.C. § 102(b) rejection of claim 45 by Lavigne; the 35 U.S.C. § 102(e) rejection of claim 45 by Higham; the 35 U.S.C. § 103(a) rejection of claim 45 by Higham; and the 35 U.S.C. § 103(a) rejection of claim 45 by Lavigne in view of Aten were all withdrawn because of the effectiveness of the Declaration. That is, the rejections involving either Higham or Lavigne in relation to claim 45 were overcome by the Declaration. It is noted that claims 46 and 47 depend from claim 45. Therefore, it follows that claims 45-47 are patentable over all rejections involving either Higham or Lavigne. Hence, it is respectfully submitted that the following rejections were overcome:

The rejection of claims 45 and 47 pursuant to 35 U.S.C. § 102(b) as anticipated by Lavigne.

The rejection of claims 45-46 pursuant to 35 U.S.C. § 102(e) as anticipated by Higham.

The rejection of claims 45-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham.

The rejection of claims 45 and 47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten.

The rejection of claims 45-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '297 in view of Lavigne.

(iii) 35 U.S.C. § 102

Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new ground of rejection.

The Pending Claims Are Not Anticipated By Lavigne

Claims 1 and 3 (and 47) were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

These rejections are respectfully traversed. Appellants traverse these rejections on the grounds that the Lavigne reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Lavigne reference.

Claim 1

Claim 1 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition." The claim further recites that "the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition."

Appellants respectfully submit that Lavigne does not disclose the recited features and relationships. The Action alleges that Lavigne discloses a "lock responsive to the computer (col. 11 L 39-43)"; "the computer operative to output a signal which changes the lock (col. 11, L 39-43; col. 8, L 59-62)"; and that the "computer is operative responsive to input of the item indicia to unlock the module (col. 8, L 24-30; col. 8 L 58-59)." The Appellants disagree.

In Lavigne, when the person in control of the carrier wishes to administer a drug, they can open the door (21), open a drawer (37, 41, 43), remove the desired drug from the carrier, and then administer the drug to the patient (Col. 14, lines 34-45). The operator also records the administration of the drug by entering a code into memory. The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which

operates to lock the door (21) and hold it in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). This alerts the user to the fact that the drugs in the carrier may have been subject to spoilage due to an out of temperature condition. An out of temperature condition (e.g., locked door 21) typically can only be cleared by the use of a pharmacist key (Col. 12, lines 60-63) which also resets the controls (Col. 11, lines 3-12). However, a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the medications even when there has been an out of temperature condition (Col. 12, line 64-Col. 13, line 2).

Appellants respectfully submit that Lavigne does not disclose using a computer to change a lock module from a locked to an unlocked condition. Lavigne, at best, is only capable of locking the door (21). The door is unlocked by use of a pharmacist key. Hence, Lavigne does not disclose using a computer to unlock a lock module.

Appellants respectfully submit that Lavigne also does not disclose a computer operative responsive to an input of an item indicia to output a signal changing the lock module to the unlocked condition. Lavigne does not disclose using a computer, which responds to inputted data, to output a signal to change a lock module from a locked condition to an unlocked condition. In Lavigne, the door (21) is unlocked by use of a pharmacist key, not by a computer. It follows that Lavigne's door (21) is not unlocked by a computer in response to inputted data.

Furthermore, nothing in Lavigne compares identification information input by a user to data stored in a data store. The memory on the Lavigne carrier holds information corresponding to the person having possession of the carrier at any given time. However there is no disclosure

or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of “authorized users.”

Claim 1 further specifically recites that responsive to the input of identification data corresponding to an authorized user, a user is enabled to input data corresponding to a medical item. Again nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database.

Additionally claim 1 specifically recites that responsive to the input of the medical item indicia (which activity is enabled when the identification data input corresponds to an authorized user), the computer is caused to output a signal, which signal changes the lock module controlling the door of the refrigerator to an unlocked condition. Nothing in Lavigne discloses or suggests controlling a lock to open the door (21) in response to either medical item indicia or identification data corresponding to an authorized user. As Lavigne makes amply clear, the door (21) of his medication carrier is always unlocked except in circumstances when an out of range temperature condition has been sensed, in which case the door will lock because a temperature violation which could have damaged the medications has occurred (see Col. 11, lines 37-43).

It is respectfully submitted that claim 1 recites numerous features and relationships which are neither disclosed nor suggested in Lavigne. Thus, Lavigne does not anticipate the claim. For these reasons it is respectfully submitted that claim 1 as well as all the claims that depend therefrom (including any claims that are currently withdrawn from consideration) should be allowed.

Claim 3

Claim 3 depends from claim 1 and further recites that “the lock module further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

Appellants respectfully submit that Lavigne does not disclose a computer operative responsive to an open door signal to change a lock module to a locked condition. In Lavigne, if the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). That is, the controller of Lavigne operates the locking solenoid (139) based on sensing temperature conditions, not on sensing whether the door was opened. In Lavigne the door (21) may be opened many times without initiating the locking solenoid (139) (Col. 9, lines 7-10; Col. 14, lines 34-37; Col. 12, lines 15-18).

The Lavigne system senses the opening of a door to record an event in memory. However, the sensing of the door opening in no way causes a lock to change its condition so that when the door of the Lavigne carrier is thereafter closed, it is held closed and locked. The portion of the Lavigne reference cited against claim 3 in the Action (Col. 6, lines 47-56) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened. Nothing in Lavigne discloses or suggests that in response to sensing the opening of a

drawer, a lock condition is changed so that the door will be locked the next time it is closed, as is specifically recited in claim 3.

Lavigne does not disclose each and every feature and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Thus, Lavigne does not anticipate the claim. Hence, Appellants' claim 3 patentably distinguishes over the Lavigne reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

Claim 47

The Notification dated April 9, 2001 indicated that the rejection of claim 47 as being anticipated by Lavigne remained in effect. That is, even though independent claim 45 was deemed patentable over Lavigne, claim 47 (which depends from claim 45) was still held to be rejected.

Appellants respectfully submit that claim 47 is patentable over Lavigne for the same reasons claim 45 was deemed patentable over Lavigne. The previously discussed reasons why claim 45 (and hence claim 47) is patentable over Lavigne are herein incorporated by reference. For consistency, more of Appellants' detailed arguments concerning the rejection of claim 47 may be found in "The Notification" area of the Brief. These additional arguments are herein incorporated by reference.

The Pending Claims Are Not Anticipated By Colson '450

Claim 1 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '450.

This rejection is respectfully traversed. Appellants traverse this rejection on the grounds that the Colson '450 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claim. The features recited in Appellants' claim patentably distinguish over the Colson '450 reference.

Claim 1

Claim 1 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the data store includes user data representative of a plurality of authorized users." The claim further recites that "responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device." The claim further recites that "the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition."

Appellants respectfully submit that Colson '450 does not disclose the recited features and relationships. The Action alleges that Colson '450 discloses that a "data store includes user data representative of a plurality of authorized users (col. 5, L 17-29; Fig. 1. #21)." The Appellants disagree. The referenced section is not pertinent to a data store having user data representative of a plurality of authorized users. In the cited section of Colson '450, the user inputs "information concerning the particular patient and information as to the person entering the data" (Col. 5, lines 17-19). The patient's record (reflecting the inputted patient information and the user, e.g., the particular nurse) may be simultaneously and automatically updated (Col. 5, lines 20-29).

Information may even be processed in real-time (Col. 3, lines 45-57). However, there is no indication that Colson '450 is concerned with the user being an authorized user.

Colson does not state that any comparison is made of the information that is input as to the person entering the data, to any data concerning authorized users, or to any data stored in a data store. The operation of Colson merely specifies that information is input, the door is unlocked, and records are updated.

Appellants respectfully submit that Colson '450 does not disclose the capability of inputting identification data through an input device corresponding to the data representative of an authorized user stored in a data store. Colson '450 does not use data representative of an authorized user. Colson '450 does not use data representative of an authorized user stored in a data store.

Furthermore, Colson '450 does not disclose that in response to a user inputting identification data corresponding to an authorized user, the computer enables the user to input data corresponding to a medical item through the input device. Colson '450 does not disclose the capability of checking whether a user is an authorized user. Colson '450 does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to an authorized user data.

Additionally, as previously discussed, the user in Colson '450 inputs "information concerning the particular patient and information as to the person entering the data" (Col. 5, lines 17-19). Hence, it appears that the user in Colson '450 actually inputs the "information concerning the particular patient" prior to inputting the "information as to the person entering the

data.” This is further evidence that Colson ‘450 is not concerned with the user being an authorized user. Additionally, the use of the inputted user information appears to be only for the patient’s record, e.g., the nurse that supplied the medication.

Again, there is no disclosure or suggestion whatsoever in Colson ‘450 that Colson ‘450 has a computer in connection with a data store with authorized user data, data representative of medical items, and data corresponding to storage locations where medical items are stored. Further nothing in Colson ‘450 discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users. As Colson ‘450 expressly indicates (Col. 5, lines 17-29), a user of the Colson ‘450 device inputs information concerning a patient and information on the person entering the data, and the door opens. There is no teaching, suggestion, or motivation in Colson ‘450 that a comparison is made of input user identification data to data concerning a plurality of authorized users.

Claim 1 also specifically recites that the computer enables a user to input indicia corresponding to a medical item through an input device. As Colson ‘450 expressly indicates (Col. 5, lines 17-29), no item indicia corresponding to a medical item is input into the Colson ‘450 computer. Colson ‘450 only inputs information concerning a patient and the person entering the data, which then causes a door to open. Nothing in Colson ‘450 discloses or suggests the feature of a computer enabling a user to input indicia corresponding to a medical item through an input device, which is specifically recited in claim 1.

Claim 1 further recites that the computer is operative responsive to input of the item indicia corresponding to a medical item, to output a signal changing a lock from a locked to an

unlocked condition, enabling opening a door of the refrigerator. Again, Colson '450 does not disclose or suggest the input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock.

It is respectfully submitted that claim 1 recites numerous features and relationships which are neither disclosed nor suggested in Colson '450. Thus, Colson '450 does not anticipate the claim. For these reasons it is respectfully submitted that claim 1 as well as all the claims that depend therefrom (including any claims that are currently withdrawn from consideration) should be allowed.

The Pending Claims Are Not Anticipated By Higham

Claim 46

The Notification dated April 9, 2001 indicated that the rejection of claim 46 as being anticipated by Higham remained in effect. That is, even though independent claim 45 was deemed patentable over Higham, claim 46 (which depends from claim 45) was still held to be rejected.

Appellants respectfully submit that claim 46 is patentable over Higham for the same reasons claim 45 was deemed patentable over Higham. The previously discussed reasons why claim 45 (and hence claim 46) is patentable over Higham are herein incorporated by reference. For consistency, more of Appellants' detailed arguments concerning the rejection of claim 46 may be found in "The Notification" area of the Brief. These additional arguments are herein incorporated by reference.

The Pending Claims Are Not Anticipated By Colson '297

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '297.

This rejection is respectfully traversed. Appellants traverse this rejection on the grounds that the Colson '297 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claim patentably distinguish over the Colson '297 reference.

Claim 45

Claim 45 is an independent claim which is specifically directed to a “system for providing medical items.” The claim specifically recites that “the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” The claim further recites that “responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.”

It is respectfully submitted that claim 45 recites features and relationships that are plainly not found in Colson '297. In contrast to the elements recited in claim 45, the system in Colson '297 does not disclose a computer with a data store having stored user information corresponding

to “authorized users.” Further, Colson '297 does not have a computer that operates responsive to the input of data that corresponds to one of the authorized users, to enable input of indicia which identifies a medical item. Colson '297 operates in the manner expressly indicated therein (e.g., Col. 4, lines 39-52). Inputs through a keyboard identifying a medical item and identifying a person cause a door to unlock. There is no disclosure or suggestion of comparing the input concerning the person taking the item, to data in a data store containing data for a plurality of authorized users. Colson '297 simply receives the data and apparently stores the data for later recovery. There is no ability to compare input data to previously stored data, as expressly recited in the claim.

Further there is no disclosure in Colson '297 of the feature that a computer operates in response to determining that the input user data corresponds to one of the authorized users, to then enable input of indicia identifying a medical item. According to Colson '297, identifying information concerning a medical item can be input at any time and is apparently input before any user information (Col. 4, lines 39-52). Colson '297 further fails to disclose or suggest this feature which is expressly recited in claim 45.

Claim 45 also recites that the data store in operative connection with the computer includes location data representative of storage locations in which medical items are stored. The cited portions of Colson '297 do not disclose a data store, nor a data store including location data representative of storage locations in which particular medical items are stored. Further Colson '297 does not disclose the relationship as specifically recited in claim 45, that the computer operates to enable the input of item indicia corresponding to a medical item responsive to receipt

of identifying data corresponding to data for an authorized user among a plurality of authorized users for whom data is stored, and the computer then operating responsive to the item indicia to generate a signal changing the condition of the lock to an open condition.

It is respectfully submitted that claim 45 recites numerous features and relationships which are neither disclosed nor suggested in Colson '297. Thus, Colson '297 does not anticipate the claim. For these reasons it is respectfully submitted that claim 45 as well as all the claims that depend therefrom should be allowed.

(iv) 35 U.S.C. § 103

Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new ground of rejection.

The Pending Claims Are Not Obvious Over Lavigne

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching,

suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

Claims 1 and 3

As previously discussed, claims 1 and 3 recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. The rejection on the basis of Lavigne alone does not overcome the deficiencies of the rejections already discussed, which rejections assert that the pending claims 1 and 3 are anticipated by the same reference. As the reference does not disclose or suggest all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis. Appellants' remarks, concerning the anticipation of claims 1 and 3 by the Lavigne reference, are herein incorporated by reference.

Claim 2

Claim 2 depends from claim 1 and further recites that "the lock module further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the signal that the door is enabled to be opened."

The Action alleges that Lavigne shows a visual indicator proximate the lock (Col. 11, lines 3-43). Hence, the Action inherently admits that Lavigne lacks a lock module comprising a visual indicator. The Action alleges that it would have been obvious to place a visual indicator on Lavigne's lock. Appellants disagree.

Appellants respectfully submit that Lavigne does not disclose a lock module comprising a visual indicator. In Lavigne, at best it is the control module (31) which has a visual indicator (LEDs 75) (Col. 5, lines 54-57), not a lock module.

Also, the Action has not shown any reason or motivation to combine, or explained how or why a visual indicator would be placed on Lavigne's locking arrangement (solenoid 139) as alleged. Especially when the control module (31) already has a visual indicator. Thus, any attempt to dramatically change the structural arrangement of Lavigne would go directly against the implicit teaching of the Lavigne reference and would destroy the reference. That is, the alleged modification to Lavigne would destroy the disclosed utility or operability of the Lavigne teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to have provided Lavigne with a visual indicator in the manner recited.

Furthermore, claim 2 specifically recites that the visual indicator provides an indication that the door is enabled to be opened. In Lavigne, the indicator lights (LEDs 75) only indicate a temperature condition (Col. 11, lines 25-43), not the door's opening condition. For example, if a temperature violation has occurred for the temperature sensitive items in the drawers (37) then the door (21) will lock (Col. 11, lines 37-41). However, if the temperature violation has occurred in the refrigerated drawer (47) then the door (21) can still be opened (Col. 11, lines 41-43). Hence, it appears that upon an occurrence of a temperature violation one would be unable to

determine from the LED whether the door (21) is enabled to be opened. Any attempt to modify Lavigne to include a lock module comprising a visual indicator to provide an indication that a door is enabled to be opened is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is impermissible. Thus, Lavigne does not disclose or suggest a visual indicator for providing an indication that a door is enabled to be opened.

Furthermore, claim 2 recites that "the visual indicator provides an indication responsive to the signal that the door is enabled to be opened." From claim 1, the "signal" is from a computer to change the lock module from a locked to an unlocked condition. Lavigne does not disclose or suggest that a visual indicator is responsive to a signal (from a computer) to change a lock module from a locked to an unlocked condition. Contrarily, as previously discussed, Lavigne, at best, only discloses changing a locking solenoid (139) from an unlocked to a locked condition. Thus, Lavigne actually teaches away from the subject matter recited in claim 2.

It is respectfully submitted that the rejection on the basis of Lavigne should be withdrawn as it fails to establish that all the features recited in Appellants' claim are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

The Pending Claims Are Not Obvious Over Higham

Claims 46 and 47

The Notification dated April 9, 2001 indicated that the rejection of claims 46-47 as obvious over Higham remained in effect. That is, even though independent claim 45 was

deemed patentable over Higham, claims 46-47 (which depend from claim 45) were still held to be rejected.

Appellants respectfully submit that claims 46-47 are patentable over Higham for the same reasons claim 45 was deemed patentable over Higham. The previously discussed reasons why claim 45 (and hence claims 46-47) is patentable over Higham are herein incorporated by reference. For consistency, more of Appellants' detailed arguments concerning the rejections of claims 46-47 may be found in "The Notification" area of the Brief. These additional arguments are herein incorporated by reference.

The Pending Claims Are Not Obvious Over Colson '297

Claims 45-46 were rejected under 35 U.S.C. § 103(a) as obvious over Colson '297. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

Claim 45

As previously discussed, claim 45 recites numerous features and relationships that are not found in Colson '297. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claim is at least known in the prior art. MPEP § 2142. The rejection on the basis of Colson '297 alone does not overcome the

deficiencies of the rejections already discussed, which rejections assert that the pending claim 45 is anticipated by the same reference. Thus, as the reference does not disclose or suggest all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis. Appellants' remarks, concerning the anticipation of claim 45 by the Colson '297 reference, are herein incorporated by reference.

Claim 46

Claim 46 depends from claim 45 and further recites that "the lock further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the at least one signal that the door is enabled to be opened."

The Action alleges that Colson '297 shows that a "lock comprises a visual indicator illuminating the region of the store medication item (col. 3, L 10-16)." The Action then alleges that it would have been obvious to "modify the illumination to a visual indicator on released lock." Appellants disagree.

Appellants respectfully submit that Colson '297 does not disclose a lock comprising a visual indicator. The Action's cited section of Colson '297 (Col. 3, lines 10-16) refers to electric lighting which is further discussed at Col. 6, lines 57-68. Colson '297 does not disclose a lock comprising the electric lighting. Instead the electric lighting of Colson '297 comprises lamps (109) in the interior of a cabinet (3). The doors (19) have a transparent window (23). The electric lighting provides illumination to help a user locate stored items (Col. 6, lines 57-68). The Action has not shown any reason or motivation to combine, or explained how or why the

electric lighting of Colson '297 would be placed with a locking arrangement as alleged, especially since the illumination by interior lamps (109) are apparently already seen through the transparent windows (23). Any attempt to dramatically change the structural arrangement of Colson '297 would go directly against the implicit teaching of the Colson '297 reference and would destroy the reference. That is, the alleged modification to Colson '297 would destroy the disclosed utility or operability of the Colson '297 teaching, especially the disclosed use of the lamps (109) placed in the cabinet (3) to provide the illumination in the cabinet to find an item. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to have provided Colson '297 with a visual indicator in the manner recited.

Furthermore, claim 46 specifically recites that the visual indicator of the lock provides an indication that a door is enabled to be opened in the manner recited. It is not seen where Colson '297 teaches that the electric lighting (109) provides a visual indication of a condition of a lock showing that a door is enabled to be opened. Colson '297 teaches merely that the electric lighting (109) provides illumination. Thus, Colson '297 does not disclose or suggest a visual indicator for providing an indication that a door is enabled to be opened in the manner recited. Any attempt to modify Colson '297 to include a lock comprising a visual indicator to provide an indication that a door is enabled to be opened is clearly an attempt at hindsight reconstruction of

Appellants' claimed invention, which is impermissible. It follows that it would not have been obvious to have modified Colson '297 in the manner alleged.

Furthermore, claim 46 recites that "the visual indicator provides an indication responsive to the at least one signal that the door is enabled to be opened." From claim 45, the "signal" is from a computer to change the lock from a locked to an unlocked condition. Colson '297 does not disclose or suggest that a visual indicator is responsive to a signal (from a computer) to change a lock from a locked to an unlocked condition. Thus, Colson '297 does not teach or suggest the subject matter recited in claim 46. It follows that it would not have been obvious to have modified Colson '297 in the manner alleged.

It is respectfully submitted that the rejection on the basis of Colson '297 should be withdrawn as it fails to establish that all the features recited in Appellants' claims are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

The Pending Claims Are Not Obvious Over Lavigne In View of Aten

Claims 1 and 3 (and 47) were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne in view of Aten. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

Claims 1 and 3

As previously discussed, claims 1 and 3 recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. Appellants' remarks, concerning the anticipation of claims 1 and 3 by the Lavigne reference, are herein incorporated by reference.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion or motivation in any cited art to produce Appellants' claimed features and relationships. Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion in the Action concerning the combination with Aten that mentions any features recited in any of the pending claims, might concern claim 26, which relates to a permanent magnet referred to in the rejection, although this claim is not mentioned. Nevertheless, the alleged permanent magnet feature is not recited in claims 1 or 3. The Action is silent as to why Aten was applied against claims 1 or 3. The Action is silent as to how Aten relates to claims 1 or 3. Nor has the Action explained how the teachings of Aten could have been used to modify Lavigne to teach the recited features and relationships of claims 1 and 3.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claims are allegedly found in the cited art. Nor is there

any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claims, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claims. Therefore, claims 1 and 3 would not have been obvious to one having ordinary skill in the art.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claims are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

Claim 47

The Notification dated April 9, 2001 indicated that the rejection of claim 47 as obvious over Lavigne in view of Aten remained in effect. That is, even though independent claim 45 was deemed patentable over Lavigne in view of Aten, claim 47 (which depends from claim 45) was still held to be rejected.

Appellants respectfully submit that claim 47 is patentable over Lavigne in view of Aten for the same reasons claim 45 was deemed patentable over Lavigne in view of Aten. The previously discussed reasons why claim 45 (and hence claim 47) is patentable over Lavigne in view of Aten are herein incorporated by reference. For consistency, more of Appellants' detailed arguments concerning the rejection of claim 47 may be found in "The Notification" area of the Brief. These additional arguments are herein incorporated by reference.

The Pending Claims Are Not Obvious Over Colson '450 In View of Lavigne

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as obvious over Colson '450 in view of Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

As previously discussed, claim 1 recites numerous features and relationships that are not found in Colson '450. Appellants' remarks, concerning the rejection of claim 1 based upon the Colson '450 reference, are herein incorporated by reference.

As previously discussed, claims 1-3 recite numerous features and relationships that are not found in Lavigne. Appellants' remarks, concerning the rejections of claims 1-3 based upon the Lavigne reference, are herein incorporated by reference.

The discussion in the rejection suggests that it may be addressing to some extent only the features recited in claim 2. This is because claim 2 is the only claim currently under consideration that discusses a “visual indicator.”

The Action is silent as to why Lavigne was applied against claims 1 or 3. The Action is silent as to how Lavigne relates to claims 1 or 3. Nor has the Action explained how the teachings of Lavigne could have been used to modify Colson '450 to teach the recited features and relationships of claims 1 and 3.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants’ claims 1 and 3 are allegedly found in the cited art. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claims, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants’ claims. Therefore, the claims would not have been obvious to one having ordinary skill in the art.

Claim 1

Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP §

2142. The rejection on the basis of Colson '450 and Lavigne does not overcome the deficiencies of the rejections already discussed, which rejections assert for example that pending claim 1 is anticipated by these same references. Thus, as the Colson '450 and Lavigne references do not disclose all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis.

The rejection on the basis of Colson '450 in view of Lavigne is further respectfully submitted to be improper because it fails to indicate specifically to which claims the asserted features of these references are applied. Rather the rejection leaves the Appellants to speculate as to the assertions being made. As the rejection presented does not comply with the Manual of Patent Examining Procedure in providing Appellants with adequate notice as to which claims the features of the cited art are being applied, it is further respectfully submitted that the rejection is improper and should be withdrawn.

As previously discussed, Colson '450 does not disclose the capability of inputting identification data through an input device, corresponding to the data representative of an authorized user stored in a data store. Colson '450 does not use data representative of an authorized user. Colson '450 does not use data representative of an authorized user stored in a data store. Nothing in Colson '450 discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users.

As previously discussed, nothing in Lavigne compares identification information input by a user to authorized user data stored in a data store. The memory on the Lavigne carrier only holds information corresponding to the person having possession of the carrier at any given time

through their respective keys (Col. 8, lines 26-29). However, there is no disclosure or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of “authorized users.” Hence, Lavigne cannot overcome the deficiencies of Colson ‘450 as it does not disclose or suggest the recited features which are absent in Colson ‘450.

Furthermore, Colson ‘450 does not disclose that in response to a user inputting identification data corresponding to an authorized user, the computer enables the user to input data corresponding to a medical item through the input device. Colson ‘450 does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to data for an authorized user.

Nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database. Hence, Lavigne cannot overcome the deficiencies of Colson ‘450 as it does not disclose or suggest the recited features which are absent in Colson ‘450.

Neither Colson ‘450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ invention, it is respectfully submitted that the claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Claim 2

Claim 2 depends from claim 1 and further recites that “the lock module further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the signal that the door is enabled to be opened.”

The rejection on the basis of Colson '450 and Lavigne admits that Colson '450 alone does not disclose a visual indicator located on a lock. The Action then goes on to state (without any citation to any teaching, suggestion, or motivation in the cited art) that it would be “obvious to substitute location of the visual indicator to the lock as a matter of design choice because proximate placement of a visual indicator is sufficient to indicate to the user the location of the compartment(s) and the status of the lock corresponds with the compartment access commands from the computer (Col. 6, lines 47-56; Col. 7, lines 10-35).” Appellants respectfully submit that this assertion is not sufficient to reject the pending claim.

The Action admits that Colson '450 does not disclose a visual indicator located on a lock. It follows that Colson '450 does not disclose a visual indicator that provides an indication responsive to a signal from a computer that causes the lock to be changed from a locked condition to an unlocked condition.

As previously discussed Lavigne also does not disclose or suggest these features. Appellants’ remarks, concerning the rejection of claim 2 based on the Lavigne reference, are herein incorporated by reference.

The Action alleges (in paragraph 11) that Lavigne shows a visual indicator proximate the lock (Col. 11, lines 3-43). The Action alleges that it would have been obvious to place a visual

indicator on the Lavigne's lock. Hence, the Action inherently admits that Lavigne lacks a lock module comprising a visual indicator. Appellants respectfully submit that in Lavigne, it is the control module (31) which has a visual indicator (LEDs 75) (Col. 5, lines 54-57), not a lock module. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest the recited features which are admittedly absent in Colson '450.

Furthermore, claim 2 specifically recites that the visual indicator provides an indication that the door is enabled to be opened. In Lavigne, the indicator lights (LEDs 75) only indicate a temperature condition (Col. 11, lines 25-43), not the door's locked or unlocked condition. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest the recited features which are absent in Colson '450.

Furthermore, claim 2 recites that "the visual indicator provides an indication responsive to the signal that the door is enabled to be opened." From claim 1, the "signal" is from a computer to change the lock module from a locked to an unlocked condition. Lavigne does not disclose or suggest that a visual indicator is responsive to a signal (from a computer) to change a lock module from a locked to an unlocked condition. Contrarily, as previously discussed, Lavigne, at best, only discloses changing a locking solenoid (139) from a normally unlocked condition, to a locked condition. Thus, Lavigne actually teaches away from the subject matter recited in claim 2. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest the recited features which are absent in Colson '450.

It is respectfully submitted that the rejection on the basis of Colson '450 in view of Lavigne should be withdrawn as it fails to establish that all the features recited in Appellants'

claims are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

Claim 3

Claim 3 depends from claim 1 and further recites that “the lock module further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

The Action admits that Colson ‘450 does not disclose “a door sensor; door is operative to generate an open signal responsive to the door opening.” The Action then alleges that Lavigne “discloses a door sensor with the door operative to generate an open signal responsive to the door opening.” The Action further alleges that it would have been “obvious to use a sensor to detect the opening of the door as a means of saving power and recording removal of the item as taught by Colson” ‘450.

The Action admits that Colson ‘450 does not disclose a “door sensor” or that “the door sensor is operative to generate an open signal responsive to opening the door.” It follows that Colson ‘450 lacks a lock module comprising a door sensor. It further follows that Colson ‘450 lacks that a “computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

The Lavigne system senses the opening of a door to record an event in memory. However, the sensing of the door opening in no way causes a lock to change its condition so that when the door of the Lavigne carrier is thereafter closed, it is held closed and locked. The portion of the Lavigne reference cited against claim 3 (in paragraph 5) in the Action (Col. 6, lines 47-56) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened. Nothing in Lavigne discloses or suggests that in response to sensing the opening of a drawer, a lock condition is changed so that the door will be locked the next time it is closed, as is specifically recited in claim 3.

Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest the recited features which are admittedly absent in Colson '450.

It is respectfully submitted that the rejection on the basis of Colson '450 in view of Lavigne should be withdrawn as it fails to establish that all the features recited in Appellants' claims are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

The Pending Claims Are Not Obvious Over Blechl In View of Weinberger

Claims 45-47 were rejected under 35 U.S.C. § 103(a) as obvious over Blechl in view of Weinberger. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching,

suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

Before a claim may be rejected on the basis of obviousness the Patent Office must show that all the recited features of the claim are known in the prior art. MPEP § 2142. In addition to showing that all the features and relationships are known in prior art references, the Patent Office further bears the burden of showing in the cited art a specific teaching, suggestion or motivation to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987). The teaching, suggestion or motivation to combine features in prior art references must be *clearly* and *particularly* identified in such prior art to support a rejection on the basis of obviousness. *In re Dembiczak*, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999).

The rejection based on the alleged combination of Blechl and Weinberger is legally improper under this standard for several reasons. First, the Action does not state which features in the claims are absent in Blechl that require the addition of Weinberger's teachings. Secondly, no specific feature of Weinberger is identified as contributing to the features asserted to be added into Blechl. The discussion of Weinberger in the Action does not point to any feature or any specific area of that disclosure which is asserted to be pertinent to the claims at issue. In addition there is no specific or particular teaching cited in either prior art reference that would cause one skilled in the art to produce the claimed invention. The only comments concerning Weinberger in the Action are as follows:

“It would have been obvious for Blechl to include a visual indicator as a part of a lock module because a visual signal can direct the user to the correct door/drawer as taught by Weinberger. It would have been obvious for Blechl to have the computer lock the door responsive to a sensor indicating door closure because locking the door can reduce unauthorized access as taught by Weinberger.”

Where does Weinberger teach a lock module with a visual signal that directs a user to a correct door/drawer? Where does Weinberger have a computer lock a door responsive to a sensor indicating a door closure? Where is there any specific teaching in Weinberger or Blechl to make the asserted combination?

The Manual of Patent Examining Procedure specifically requires that the Patent Office clearly and fully state any grounds for any rejection. MPEP § 707.07(d). It is respectfully submitted that the rejections fail to satisfy those requirements and should be withdrawn as legally improper.

Claim 45

Claim 45 is an independent claim which is specifically directed to a “system for providing medical items.” The claim specifically recites that “the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” The claim further recites that

“responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.” Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim.

Blechl does not disclose or suggest a computer in operative connection with a data store, which data store includes data for a plurality of authorized users. Indeed the express description of Blechl's operation makes clear that Blechl does not include a data store which holds information for a plurality of authorized users. Instead Blechl has each user insert a magnetic card which is read by a card reader. Blechl's device then requires the user to input a personal identification number (PIN). The input PIN is then compared to the card which is read and if there is a match, access is allowed (Col. 4, lines 23-34; Col. 9, lines 13-19). As a result Blechl makes it very clear that it has no computer connected to a data store holding data for a plurality of authorized users.

Blechl uses a card containing data (corresponding to the user's PIN) for a single user, not a data store holding data for a plurality of authorized users. Blechl simply compares the card data with the PIN inputted by a single user to determine if the system may be operated by that particular user. The inputted PIN is only compared to the data on the card. The inputted card data and PIN is not compared via a computer to the card data and PINs of a plurality of

authorized users stored in a data store. Furthermore, the routines from which the user is authorized to select are determined by the routine information programmed into the card. Blechl, at best, uses microprocessing means to compare the card data (for a single user) to the inputted PIN. Therefore, Blechl does not disclose a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users. Furthermore, there is no teaching, suggestion, or motivation in Blechl for comparing inputted user identification data, to data in a data store containing data for a plurality of authorized users.

Weinberger does not disclose or suggest a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users. Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features which are absent in Blechl.

Blechl suggests that an IC card or a magnetic card need not be used alone to initiate drug dispensing from the device, but that additional input means (e.g., a PIN) may be used in conjunction with the card (Col. 4, lines 20-34; Col. 9, lines 13-19). For example, a personal identification number (numerical password) may be used with the card so that if the data on the card matches the input numerical password, drugs can be dispensed (Col. 9, lines 13-19). Blechl also suggests that more secure operation control means may be used in conjunction with the card when extremely sensitive drugs are involved (Col. 4, lines 34-36). The more secure means may involve finger print or retina scan (Col. 4, lines 34-36), or passwords, fingerprints, voice identification, or hand prints (Col. 8, lines 60-68). The data for the additional operation control means, like the PIN, is stored on the card. Blechl provides no other embodiments for enabling

operation of his device other than by using a card with data stored thereon. Furthermore, Blechl provides no disclosure or suggestion of using a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users.

Furthermore, claim 45 specifically recites that “the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” That is, the recited data store includes data representative of (1) a plurality of authorized users, (2) a plurality of medical items, and (3) storage locations in which the medical items are stored. Appellants respectively submit that Blechl’s card does not include data representative of (1), (2), or (3). It follows that Blechl’s card does not include data representative of (1), (2), and (3). Nor does Blechl disclose or suggest that a “computer is in operative connection with a data store” which includes data representative of (1), (2), and (3).

Weinberger does not disclose or suggest a data store including data representative of a plurality of authorized users, a plurality of medical items, and storage locations in which the medical items are stored. Hence, Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features which are absent in Blechl.

Furthermore, claim 45 specifically recites “a user interface in operative connection with the computer, wherein the interface includes at least one input device.” Claim 45 further recites that a user is capable of “inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store.” Claim 45 further recites

that a user is capable of inputting “item indicia corresponding to a medical item through the at least one input device.” That is, the user is capable of inputting both “identification data” and “item indicia” “through the at least one input device.” In Blechl the user identification unit (247) is specifically designed to be separate from the medication input unit (248). Note Col. 8, lines 45-51, and Figures 12 and 19.

Claim 45 further recites that responsive to input of data corresponding to one of the plurality of authorized users stored in the data store, the computer of the recited invention enables a user to input item indicia corresponding to a medical item through at least one input device. The Action asserts that Blechl has an input device at Col. 4, lines 39-50. This portion of Blechl does not stand for the proposition asserted in the Action. Instead it talks about a mechanic or pharmacist accessing the interior of Blechl’s device. It is discussed that such a mechanic or pharmacist can gain access by inputting a matching card and PIN and allowing a door (38) to be opened through a touch screen (30) and operation of a processor. However, there is no disclosure that the touch screen is only enabled to receive inputs in response to prior receipt of a matching card and PIN. There is certainly no disclosure or suggestion that the mechanic or pharmacist inputs through the touch screen, indicia corresponding to a particular medical item. Indeed there is no particular medical item that is accessed by opening the door (38). As Blechl does not disclose these features and relationships which are expressly recited in claim 45, claim 45 is further allowable on this basis.

Weinberger does not disclose or suggest that responsive to input of data corresponding to one of the plurality of authorized users stored in a data store, a computer enables a user to input

item indicia corresponding to a medical item through at least one input device. Hence, Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features which are absent in Blechl.

In the Action only the features of Blechl are cited as allegedly pertinent to claim 45. No specific features of Weinberger have been cited with regard to claim 45. However, because no 35 U.S.C. § 102 type of rejection was presented against claim 45 based on Blechl, the Action inherently admits that Blechl does not anticipate claim 45. As the Action cites no source of other features, or any teaching, suggestion or motivation in the relevant art to modify Blechl so as to produce the invention specifically recited in claim 45, the Action does not present a valid 35 U.S.C. § 103(a) rejection, and claim 45 is allowable.

Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It is respectfully submitted that the claims that depend from claim 45 (claims 46-47) are also allowable.

Claim 46

Claim 46 depends from claim 45 and further recites that the lock comprises a visual indicator which provides an indication responsive to at least one signal that the door is enabled to

be opened. The Action cites Blechl (Col. 7, lines 13-34) as disclosing such a feature. Appellants respectfully submit that this portion of Blechl does not disclose or suggest such a feature.

The cited portion of Blechl refers to a wire (124) shown in Figure 6 which extends through a pair of apertures in a cartridge. The wire is broken to release the medication containers stored in the cartridge. The unbroken condition of the wire indicates that none of the medication containers have been removed.

This breakable wire (124) of Blechl in no way provides a visual indication in response to at least one signal from a computer as specifically recited in claim 46. Furthermore, the wire (124) of Blechl does not provide an indication that a door is enabled to be opened as specifically recited in claim 46.

The Action apparently asserts that Weinberger includes a lock module which provides a visual signal that directs a user to a correct door/drawer. However, no portion of Weinberger is cited for this teaching. Nor is it seen where Weinberger discloses such alleged features. Further, no teaching, suggestion, or motivation for combining features of Weinberger with features of Blechl is presented in the Action.

Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is respectfully submitted that claim 46 is further allowable for these reasons.

Claim 47

Claim 47 depends from claim 45 and further recites that the lock comprises a door sensor. The door sensor is operative to generate an open signal responsive to opening the door. Claim 47

further recites that the computer operates responsive to the open signal to change the lock to the locked condition. As a result when the door is next returned to a closed condition, the door is held closed.

The Action cites Col. 13, lines 20-30 of Blechl as disclosing this feature. However, Blechl ends at Col. 13, line 27. In addition the cited portions of Blechl are Blechl's claims 17-19 which teach, disclose, or suggest nothing concerning the features specifically recited in claim 47. Thus, no portion of Blechl is cited for this teaching. Nor is it seen where Blechl discloses such alleged features.

The Action asserts that Weinberger includes a computer to lock a door responsive to a sensor indicating door closure. However, no particular element or portion of the Weinberger is cited in the Action as disclosing this particular feature. Furthermore, no specific teaching, suggestion, or motivation is cited in either Weinberger or Blechl for combining features so as to produce what is expressly recited in claim 47.

Claim 47 specifically recites that "the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock to the locked condition, wherein when the door is next returned to a closed condition the door is held therein."

In Blechl the user manually closes the door/drawer. The "latch mechanism secures the drawer and communicates to the microprocessing means that the drawer has been closed" (Col. 9, lines 56-64). That is, at best, a closed door signal is generated, not an open door signal as recited.

Blechl's computer is not operative responsive to an open signal. Nor does it appear that Blechl's computer is even operative responsive to a closed signal. It follows that Blechl's computer is not responsive to an open signal to change a lock to a locked condition. Contrarily, in Blechl the microprocessor is notified only after the door/drawer has been closed and apparently after the door/drawer has already been locked (secured). Hence, there is no need for the computer to change the lock to the locked condition.

The claim further recites that the computer changes the lock to the locked condition so that "when the door is next returned to a closed condition the door is held therein." That is, the computer places the lock in the locked condition prior to the door being returned to the closed condition. In Blechl "latch mechanism secures the drawer and communicates to the microprocessing means that the drawer has been closed" (Col. 9, lines 56-64). That is, in Blechl's system the door is first closed and secured then the microprocessing means is notified. Blechl does not teach or suggest, nor does Blechl appear capable of, the microprocessing means initiating a locked condition prior to the door being closed. Nor does Blechl teach or suggest the microprocessing means initiating a locked condition prior to the door being closed in response to the door being open.

The Action states that "It would have been obvious for Blechl to have the computer to lock the door responsive to a sensor indicating door closure because locking the door can reduce unauthorized access as taught by Weinberger." It is noted that the Action refers to "a sensor indicating door closure." However, claim 47 clearly recites that the "door sensor is operative to generate an open signal responsive to opening the door." It is respectfully submitted that the

Action's starting basis for obviousness is completely opposite to the recited claim language.

Thus, even if the references were combined in the manner alleged, the combination would still not meet the claimed invention.

As noted above Blechl lacks many of the recited features and relationships. Weinberger also does not disclose or suggest that a "door sensor is operative to generate an open signal responsive to opening the door", nor that a "computer is operative responsive to the open signal to change the lock to the locked condition", nor that "when the door is next returned to a closed condition the door is held therein." No portion of Weinberger is cited for these recited features and relationships. Nor is it seen where Weinberger discloses such alleged features and relationships. Further, no teaching, suggestion, or motivation for combining features of Weinberger with features of Blechl is presented in the Action. Hence, Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features and relationships which are absent in Blechl.

Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is respectfully submitted that claim 47 is further allowable for these reasons.

Appellants' Claims Should Be Allowed Because the Action Has Not Shown That the Features and Relationships Claimed Are Known in the Prior Art

It is respectfully submitted that all the pending claims should be allowed because the Action has failed to recite with the legally required specificity, where the recited elements are

shown in the prior art. In the case of all obviousness rejections, the Action has failed to specify a teaching, suggestion, or motivation found in the prior art for purposes of making the claimed combination.

It is respectfully submitted that the citation in the Action to blocks of text without any reference to the particular feature or teaching which is alleged to correspond to the recited claim elements, does not provide in a legally sufficient basis for rejecting the claims. Further, as discussed in detail in relation to the rejections which were not overcome by swearing behind the cited references, the portions of the references cited in the Office Action generally do not stand for the propositions asserted in the Action and often have no bearing whatsoever to the features specifically recited.

Appellants respectfully submit that in view of the plainly legally insufficient basis for rejecting Appellants' claims, that all of the claims should be allowed.

The Claims Also Patentably Distinguish Over The References That Were Sworn Behind

Because Lavigne, Colson '450, Pearson '232, and Higham do not constitute prior art in the instant application (involving at least claims 24 and 45), Appellants find it unnecessary to discuss in this Brief the detailed reasons why these references (and their involved rejections) do not anticipate or render obvious the features and relationships recited in the claims 24-26 and 45-47 against which they were cited in the Action. Nevertheless, Appellants will also show that the appealed claims patentably distinguish over these references and the following rejections:

Claims 24-25 as rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

Claim 24 as rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '450.

Claim 45 as rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson '232.

Claims 24-26 as rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne.

Claims 24-26 as rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten.

Claims 24-25 as rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Lavigne.

The Pending Claims Are Not Anticipated By Lavigne

Claims 24-25 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

This rejection is respectfully traversed. Appellants traverse this rejection on the grounds that the Lavigne reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Lavigne reference.

Claim 24

Claim 24 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition."

The claim further recites that “the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.”

Appellants respectfully submit that Lavigne does not disclose the recited features and relationships. The Action alleges that Lavigne discloses a “lock responsive to the computer (col. 11 L 39-43)”; “the computer operative to output a signal which changes the lock (col. 11, L 39-43; col. 8, L 59-62)”; and that the “computer is operative responsive to input of the item indicia to unlock the module (col. 8, L 24-30; col. 8 L 58-59).” The Appellants disagree.

As previously discussed, in Lavigne when the person in control of the carrier wishes to administer a drug, they can open the door (21) or open a drawer (37, 41, 43), remove the desired drug from the carrier, and then administer the drug to the patient (Col. 14, lines 34-45). The operator also records the administration of the drug by entering a code into memory. The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). This alerts the user to the fact that the drugs in the carrier may have been subject to spoilage due to an out of temperature condition. An out of temperature condition (e.g., locked door 21) typically can only be cleared by the use of a pharmacist key (Col. 12, lines 60-63) which also resets the controls (Col. 11, lines 3-12). However, a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the medications even when there has been an out of temperature condition (Col. 12, line 64-Col. 13, line 2).

Appellants respectfully submit that Lavigne does not disclose using a computer to change a lock module from a locked to an unlocked condition. Lavigne, at best, is only capable of locking the door (21). The door is unlocked by use of a pharmacist key. Hence, Lavigne does not disclose using a computer to unlock a lock module.

Appellants respectfully submit that Lavigne also does not disclose a computer operative responsive to an input of an item indicia to output a signal changing the lock module to the unlocked condition. Lavigne does not disclose using a computer, which responds to inputted data, to output a signal to change a lock module from a locked condition to an unlocked condition. In Lavigne, the door (21) is unlocked by use of a pharmacist key, not by a computer. It follows that Lavigne's door (21) is not unlocked by a computer in response to inputted data.

Furthermore, nothing in Lavigne compares identification information input by a user to data stored in a data store. The memory on the Lavigne carrier holds information corresponding to the person having possession of the carrier at any given time. However there is no disclosure or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of "authorized users."

Claim 24 further specifically recites that responsive to the input of identification data corresponding to an authorized user, a user is enabled to input data corresponding to a medical item. Again, nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database.

Additionally claim 24 specifically recites that responsive to the input of the medical item indicia (which activity is enabled when the identification data input corresponds to an authorized user), the computer is caused to output a signal, which signal changes the lock module controlling the door of the housing structure to an unlocked condition. Nothing in Lavigne discloses or suggests controlling a lock to open the door (21) in response to either medical item indicia or identification data corresponding to an authorized user. As Lavigne makes amply clear, the door (21) of his medication carrier is always unlocked except in circumstances when an out of range temperature condition has been sensed, in which case the door will lock because a temperature violation which could have damaged the medications has occurred (see Col. 11, lines 37-43).

It is respectfully submitted that claim 24 recites numerous features and relationships which are neither disclosed nor suggested in Lavigne. Thus not only is Lavigne not prior art, Lavigne also does not anticipate the claim. For these reasons it is respectfully submitted that claim 24 as well as all the claims that depend therefrom should be allowed.

Claim 25

Claim 25 depends from claim 24 and recites that “the lock module further includes a door sensor in operative connection with the door and the computer.” Claim 25 further recites that a “latching device is operative to hold the lock module in the unlocked position responsive to the signal.” Claim 25 further recites that “the computer is operative to cause the output of a further signal, wherein the further signal changes the lock module to a locked condition and thereafter the latching device holds the lock module in the locked condition.” Claim 25 further recites that

“the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.”

Appellants respectfully submit that Lavigne does not disclose a computer operative responsive to a sensor sensing opening of a door to change a lock module to a locked condition. Nor does Lavigne disclose a computer operative responsive to a time delay period to change a lock module to a locked condition. In Lavigne, if the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). That is, the controller of Lavigne operates the locking solenoid (139) based on sensing temperature conditions, not on sensing whether the door was opened or the passage of a time delay period. In Lavigne the door (21) may be opened many times without initiating the locking solenoid (139) (Col. 9, lines 7-10; Col. 14, lines 34-37; Col. 12, lines 15-18).

The Lavigne system senses the opening of a door to record an event in memory. However, Lavigne does not disclose or suggest that the sensing of a door opening or the passage of a time delay period causes a lock to be held in a locked condition.

The portion of the Lavigne reference cited against claim 25 in the Action (Col. 6, lines 47-56; Col. 7, lines 10-35) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened (Col. 6, lines 47-56) and locking solenoid (139) operation (Col. 7, lines 10-35). Nothing in Lavigne discloses or suggests that in response to sensing the

opening of a drawer or the passage of a time delay period, a lock module is changed to a locked condition and held in the locked condition, as is specifically recited in claim 25.

Furthermore, claim 25 recites that “the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.” Lavigne does not disclose passage of a period of time measured after the output of the signal. Nor does Lavigne determine the earlier of either sensing the opening of the door or the passage of the time delay period.

Lavigne does not disclose each and every feature and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Hence, Appellants’ claim 25 patentably distinguishes over the Lavigne reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be further withdrawn for these reasons.

The Pending Claims Are Not Anticipated By Colson ‘450

Claim 24 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson ‘450.

This rejection is respectfully traversed. Colson ‘450 is not prior art. Appellants additionally traverse this rejection on the grounds that the Colson ‘450 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants’ claim patentably distinguish over the Colson ‘450 reference.

Claim 24

Claim 24 is an independent claim which is specifically directed to a “system for providing medical items.” The claim specifically recites that “the data store includes user data representative of a plurality of authorized users.” The claim further recites that “responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device.” The claim further recites that “the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.”

Appellants respectfully submit that Colson ‘450 does not disclose the recited features and relationships. The Action alleges that Colson ‘450 discloses that a “data store includes user data representative of a plurality of authorized users (col. 5, L 17-29; Fig. 1. #21).” The Appellants disagree. The referenced section is not pertinent to a data store having user data representative of a plurality of authorized users. In the cited section of Colson ‘450, the user inputs “information concerning the particular patient and information as to the person entering the data” (Col. 5, lines 17-19). The patient’s record (reflecting the inputted patient information and the user, e.g., the particular nurse) may be simultaneously and automatically updated (Col. 5, lines 20-29). Information may even be processed in real-time (Col. 3, lines 45-57). However, there is no indication that Colson ‘450 is concerned with the user being an authorized user.

Appellants respectfully submit that Colson ‘450 does not disclose the capability of inputting identification data through an input device corresponding to data representative of an

authorized user stored in a data store. Colson '450 does not use data representative of an authorized user. Colson '450 does not use data representative of an authorized user stored in a data store.

Furthermore, Colson '450 does not disclose that in response to a user inputting identification data corresponding to an authorized user, the computer enables the user to input data corresponding to a medical item through the input device. Colson '450 does not disclose the capability of checking whether a user is an authorized user. Colson '450 does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to data for an authorized user.

Additionally as previously discussed, the user in Colson '450 inputs "information concerning the particular patient and information as to the person entering the data" (Col. 5, lines 17-19). Hence, it appears that the user in Colson '450 actually inputs the "information concerning the particular patient" prior to inputting the "information as to the person entering the data." This is further evidence that Colson '450 is not concerned with the user being an authorized user. Additionally, the use of the inputted user information appears to be only for the patient's record, e.g., the nurse that supplied the medication.

Again, there is no disclosure or suggestion whatsoever that Colson '450 has a computer in connection with a data store with authorized user data, data representative of medical items, and data corresponding to storage locations where medical items are stored. Further, nothing in Colson '450 discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users. As Colson '450

expressly indicates (Col. 5, lines 17-29), a user of the Colson '450 device inputs information concerning a patient and information on the person entering the data, and the door opens. There is no teaching, suggestion, or motivation in Colson '450 that a comparison is made of input user identification data to data concerning a plurality of authorized users.

Claim 24 also specifically recites that the computer enables a user to input indicia corresponding to a medical item through an input device. As Colson '450 expressly indicates (Col. 5, lines 17-29), no item indicia corresponding to a medical item is input into the Colson '450 computer. Colson '450 only inputs information concerning a patient and the person entering the data, which then causes a door of Colson '450 to open. Nothing in Colson '450 discloses or suggests the feature of a computer enabling a user to input indicia corresponding to a medical item through an input device, which is specifically recited in claim 24.

Claim 24 further recites that the computer is operative responsive to input of the item indicia corresponding to a medical item, to output a signal changing a lock from a locked to an unlocked condition, enabling opening a door of the housing structure. Again Colson '450 does not disclose or suggest the input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock.

It is respectfully submitted that claim 24 recites numerous features and relationships which are neither disclosed nor suggested in Colson '450. Thus, not only is Colson '450 not prior art, it also does not anticipate the claim. For these reasons it is respectfully submitted that claim 24 as well as all the claims that depend therefrom should be allowed.

The Pending Claims Are Not Anticipated By Pearson '232

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson '232.

This rejection is respectfully traversed. Pearson '232 is not prior art. Appellants also traverse this rejection on the grounds that the Pearson '232 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claim. The features recited in Appellants' claim 45 patentably distinguish over the Pearson '232 reference.

Claim 45

Claim 45 is an independent claim which is specifically directed to a “system for providing medical items.” The claim specifically recites that “the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” The claim further recites that “responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.”

It is respectfully submitted that claim 45 recites features and relationships that are plainly not found in Pearson '232. In contrast to the elements recited in claim 45, the system in Pearson '232 does not disclose a computer with a data store having stored user information corresponding

to “authorized users.” Further, Pearson ‘232 does not have a computer that operates responsive to the input of identification data that corresponds to one of the authorized users, to enable input of indica which identifies a medical item. Pearson ‘232 operates to dispense medication in the manner expressly indicated therein (e.g., Col. 4, line 60 to Col. 5, line 5). First a password is entered (via a keyboard; Col. 3, lines 13-15) by a nurse to authorize use of the dispenser. Next the nurse enters patient identification information. Next the nurse verifies that the screen displayed by the computer corresponds to the correct patient. Then the computer unlocks each container (8) or drawer (10) holding medication that the patient is scheduled to receive at that time.

During an unscheduled request (e.g., an emergency) the dispensing of medication may also occur (Col. 6, lines 6-23). However, the acting nurse has to provide their name and an explanation for the reason of the request. The computer is able to record all pertinent information, including the medications dispensed, the amount of medication, the identity of the patient, the time dispensed, the name of the nurse, and the explanation.

Pearson ‘232 does not disclose or suggest a computer in operative connection with a data store, which data store includes data for a plurality of authorized users. The device of Pearson ‘232 requires the user to input a password. The password appears to be a multi-user password which enables several different persons to access the dispenser (computer) using the same password. Thus, the arrangement of the dispenser (computer) of Pearson ‘232 is similar to a personal computer that enables access to plural users while requiring only a single password. That is, only a single password is required to access the dispenser of Pearson ‘232. Therefore,

any nurse that has been authorized to know the current password may access the medication dispenser.

Pearson '232 does not disclose or suggest that a computer operates in response to determining that the inputted user identification data corresponds to one of a plurality of different authorized users. Pearson '232 does not disclose or suggest in any manner that a plurality of different passwords are required. Nor does Pearson '232 disclose or suggest that a plurality of different passwords are required corresponding to different authorized users. Nor does Pearson '232 disclose or suggest that a plurality of different passwords are stored in a data store, where the passwords reflect data representative of a plurality of authorized users. Pearson '232 does not disclose or suggest data corresponding to a plurality of authorized users stored in a data store. Nor does Pearson '232 disclose or suggest a computer in operative connection with the data store. Nor does Pearson '232 disclose or suggest comparing (corresponding) inputted identification data with that of a plurality of authorized users' data. That is, in Pearson '232 there is no disclosure or suggestion of comparing an input password to a plurality of authorized passwords in a data store.

Furthermore, claim 45 specifically recites that "the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored." The Action has not indicated, nor is it seen, where Pearson '232 discloses a data store including data representative of a plurality of "authorized users", a plurality of "medical items", and "storage locations" in

which the medical items are stored. Nor has the Action indicated, nor is it seen, where Pearson ‘232 discloses a computer in operative connection with a data store including data representative of a plurality of authorized users, a plurality of medical items, and storage locations in which the medical items are stored.

Furthermore, there is no disclosure in Pearson ‘232 of the feature that a computer operates in response to determining that the inputted user data corresponds to one of a plurality of authorized users, to then enable input of indicia corresponding to a medical item. Pearson ‘232 does not disclose the relationship, as specifically recited in claim 45, that the computer operates to enable the input of item indicia corresponding to a medical item responsive to receipt of identifying data corresponding to data for an authorized user among a plurality of authorized users for whom data is stored, and the computer then operating responsive to the item indicia to generate a signal changing the condition of the lock to an open condition. Additionally, as previously discussed, Pearson ‘232 fails to disclose or suggest that a “data store includes user data representative of a plurality of authorized users.”

It is respectfully submitted that claim 45 recites numerous features and relationships which are neither disclosed nor suggested in Pearson ‘232. Thus, not only is Pearson ‘232 not prior art, it also does not anticipate the claim. Furthermore, even if it were somehow possible for Pearson ‘232 to be entitled to the filing date of Pearson ‘029, Pearson ‘029 also does not disclose or suggest the recited features and relationships recited in claim 45. For these reasons it is respectfully submitted that claim 45 should be allowed.

The Pending Claims Are Not Obvious Over Lavigne

Claims 24-26 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

Claims 24 and 25

As previously discussed, Lavigne is not prior art against the invention recited in claim 24. Claims 24 and 25 also recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. The rejection on the basis of Lavigne alone does not overcome the deficiencies of the rejections already discussed, which rejections assert that the pending claims 24 and 25 are anticipated by the same reference. Thus, as the reference does not disclose or suggest all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper. Appellants' remarks, concerning the anticipation of claims 24 and 25 by the Lavigne reference, are herein incorporated by reference.

Claim 26

Claim 26 depends from claim 25 and further recites that "the latching device includes a permanent magnet latching solenoid."

Appellants respectfully wish to point out the deficiency in the Action in regard to their request for a showing that the use of permanent magnet solenoids were known in the prior art of medical item dispensing systems, and for a specific citation to some teaching, suggestion, or motivation to include such a device in the recited combinations. In a prior response, Appellants challenged the assertion that an “official notice” could be taken that use of permanent magnets in solenoids is well known because such construction “averts the need for plural windings.” In response to the traverse of the “official notice” rejection, the Patent Office in the Action cited the abstracts in Keskin, Nemoto, and Tabata. However, none of these patents have to do with the relevant art of medical item dispensing systems in the manner recited. No teaching, suggestion, or motivation in the relevant art was cited to include features of these patents in connection with a medical item dispensing system. None of these patents show the alleged advantage of averting the need for plural windings, and in fact do not have such advantage. Finally, the citation in the Action to the abstract of Keskin does not appear to even discuss the use of a permanent magnet for any purpose.

Appellants respectfully submit that in view of the plainly legally insufficient basis for rejecting Appellants’ claim, that the claim should be allowed.

Appellants respectfully submit that Lavigne does not disclose a latching device including “a permanent magnet latching solenoid.” Nor does Lavigne disclose or suggest all the features and relationships (nor any teaching, suggestion, or motivation to produce the claimed combination) of claims 24 and 25 from which claim 26 depends. Therefore, the rejection is further respectfully submitted to be improper on this basis.

It is respectfully submitted that the rejection on the basis of Lavigne should be withdrawn as Lavigne is not prior art, and the rejection fails to establish that all the features and relationships recited in Appellants' claim are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

The Pending Claims Are Not Obvious Over Lavigne In View of Aten

Claims 24-26 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne in view of Aten. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Lavigne is not prior art and that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

Claims 24 and 25

As previously discussed, Lavigne does not constitute prior art against at least claim 24. Claims 24 and 25 recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. Appellants' remarks, concerning the anticipation of claims 24 and 25 by the Lavigne reference, are herein incorporated by reference.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion, or motivation in any cited art to produce Appellants' claimed features and relationships. Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion based on the combination with Aten that discusses any features recited in any of the pending claims 24-26 might concern claim 26, which relates to a permanent magnet referred to in the rejection, although this claim is not mentioned. Nevertheless, the alleged permanent magnet feature is not recited in claims 24 or 25. The Action is silent as to why Aten was applied against claims 24 or 25. The Action is silent as to how Aten relates to claims 24 or 25. Nor has the Action explained how the teachings of Aten could have been used to modify Lavigne to teach the recited features and relationships of claims 24 or 25.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claims are allegedly found in the cited art. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claims, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the

references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claim. Therefore, the claim would not have been obvious to one having ordinary skill in the art.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, and because Lavigne is not prior art, it is respectfully submitted that the claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

Claim 26

Claim 26 depends from claim 25 which depends from claim 24. Claim 26 further recites that "the latching device includes a permanent magnet latching solenoid."

The Action alleges that it would have been obvious to make the dispenser of Lavigne "with a solenoid having a permanent magnet because a construction averts the need for plural windings as taught by Aten et al. (Col. 9 L 1-30)." Hence, the Action inherently admits that Lavigne lacks a latching device including a permanent magnet latching solenoid.

Appellants disagree that Aten discloses or suggest a latching device in the manner recited. Nor does Aten at Col. 9, lines 1-30 teach to have a solenoid with a permanent magnet construction to avert the need for plural windings, as alleged in the Action.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion, or motivation in Lavigne combined with Aten to produce Appellants' claimed features and relationships.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim 26 is further allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

The Pending Claims Are Not Obvious Over Colson '450 In View of Lavigne

Claims 24-25 were rejected under 35 U.S.C. § 103(a) as obvious over Colson '450 in view of Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that neither of these references is prior art against at least independent claim 24. Appellants' claims also recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

Claim 24

As previously discussed, Lavigne and Colson '450 are each not prior art against claim 24. Claim 24 also recites numerous features and relationships that are not found in either Colson '450 or Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. Appellants' remarks, concerning the anticipation of claim 24 by the Colson '450 reference and by the Lavigne reference, are herein incorporated by reference. As previously discussed neither Colson '450 nor Lavigne disclose or suggest the features and relationships recited in claim 24. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest all of the recited features and relationships which are not found in Colson '450. It follows that the combination of Colson '450 and Lavigne also would not produce the invention recited in claim 24.

In the rejection of Colson '450 combined with Lavigne the Action does not specifically cite any features in Lavigne that are necessary to overcome the deficiencies of the Colson '450 reference alone. Nor is there any teaching, suggestion, or motivation in any cited art to produce Appellants' claimed features and relationships. Neither Colson '450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion based on the combination with Lavigne that discusses any features recited in any of the pending claims 24-25 might concern claim 25, which relates to a door sensor referred to in the rejection, although this claim is not mentioned. Nevertheless, the alleged door sensor feature is not recited in claim 24. The Action is silent as to why Lavigne was applied

against claim 24. The Action is silent as to how Lavigne relates to claim 24. Nor has the Action explained how the teachings of Lavigne could have been used to modify Colson '450 to teach the recited features and relationships of claim 24.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claim are allegedly found in the cited art. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claim, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claim. Therefore, the claim would not have been obvious to one having ordinary skill in the art.

Neither Colson '450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As both cited references are not prior art, and as nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Claim 25

Claim 25 depends from claim 24 and recites that “the lock module further includes a door sensor in operative connection with the door and the computer.” Claim 25 further recites that a “latching device is operative to hold the lock module in the unlocked position responsive to the signal.” Claim 25 further recites that “the computer is operative to cause the output of a further signal, wherein the further signal changes the lock module to a locked condition and thereafter the latching device holds the lock module in the locked condition.” Claim 25 further recites that “the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.”

The Action admits that Colson '450 does not disclose “a door sensor; door is operative to generate an open signal responsive to the door opening.” Appellants respectfully submit that Colson '450 lacks many more of the recited features and relationships. For example, Colson '450 does not use data representative of an authorized user. Colson '450 also does not use data representative of an authorized user stored in a data store. Furthermore, Colson '450 does not disclose the capability of checking whether a user is an authorized user. Colson '450 also does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to an authorized user data. There is no disclosure or suggestion whatsoever in Colson '450 of a computer in connection with a data store with authorized user data, data representative of medical items, and data corresponding to storage locations where medical items are stored. Also, Colson '450 does not disclose or suggest the

input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock. Furthermore, Colson '450 does not disclose passage of a period of time measured after the output of the signal. Nor does Colson '450 determine the earlier of either sensing the opening of a door or the passage of the time delay period.

The recited features of which Lavigne lacks in relation to claim 25 have been previously discussed. Appellants' remarks, concerning the alleged anticipation of claim 25 by the Lavigne reference, are herein incorporated by reference. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest all of the recited features and relationships which are not found in Colson '450.

The Action alleges that Lavigne "discloses a door sensor with the door operative to generate an open signal responsive to the door opening." The Action also alleges that it "would have been obvious to use a sensor to detect the opening of the door as a means of saving power and recording removal of the item as taught by Colson" '450. Appellants disagree.

The Action admits that Colson '450 does not disclose the features and relationships of a door sensor in the manner recited. Appellants respectfully submit that Lavigne also does not disclose the features and relationships of a door sensor in the manner recited. Lavigne does not disclose a computer operative responsive to a sensor sensing opening of a door to change a lock module to a locked condition. Nor does Lavigne disclose the passage of a period of time measured after the output of the signal. Nor does Colson '450 determine the earlier of either sensing the opening of a door or the passage of the time delay period. Nor does Lavigne disclose a computer operative responsive to such determination to change a lock module to a locked

condition. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest all of the recited features and relationships which are not found in Colson '450.

In Lavigne, if the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) to hold it in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). That is, the controller of Lavigne operates the locking solenoid (139) based on sensing temperature conditions, not on sensing whether the door was opened or the passage of a time delay period. In Lavigne the door (21) may be opened many times without initiating the locking solenoid (139) (Col. 9, lines 7-10; Col. 14, lines 34-37; Col. 12, lines 15-18).

The Lavigne system senses the opening of a door to record an event in memory. However, neither Colson '450 nor Lavigne disclose or suggest that the sensing of a door opening or the passage of a time delay period causes a lock to be held in a locked condition. Nothing in Colson '450 or Lavigne discloses or suggests that in response to sensing the opening of a drawer or the passage of a time delay period, a lock module is changed to a locked condition and held in the locked condition, as is specifically recited in claim 25.

Neither Colson '450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is

allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

The Notification

The Notification of non-compliance dated April 9, 2001 indicated that the following rejections remained in effect:

The rejection of claim 47 pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

The rejection of claim 46 pursuant to 35 U.S.C. § 102(e) as being anticipated by Higham.

The rejection of claims 46-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham.

The rejection of claim 47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten.

The Appellants maintain that these rejections were moot in view of the indicated patentability of claim 45 over both Higham and Lavigne. The Advisory Action indicated, and the Notification confirmed, that the 35 U.S.C. § 102(b) rejection of claim 45 by Lavigne; the 35 U.S.C. § 102(e) rejection of claim 45 by Higham; the 35 U.S.C. § 103(a) rejection of claim 45 by Higham; and the 35 U.S.C. § 103(a) rejection of claim 45 by Lavigne in view of Aten were all withdrawn because of the effectiveness of the Declaration.

Claims 46 and 47 depend on claim 45. Thus, claims 46 and 47 are likewise patentable over both Higham and Lavigne. Thus, the Office's requirement that Appellants respond to these

rejections of claims 46 and 47 is needless and only extends the length of the Brief. Nevertheless, additional arguments by Appellants' against these rejections follows.

Pending Claim 47 Is Not Anticipated By Lavigne

As admitted by the Office, claim 45 is not anticipated by Lavigne. It follows that claim 47, which depends from claim 45, is also not anticipated by Lavigne. The previously discussed reasons why claim 45 (and hence claim 47) is not anticipated by Lavigne are incorporated by reference.

Furthermore, Lavigne does not disclose using a computer to change a lock from a locked to an unlocked condition. Lavigne, at best, is only capable of locking the door (21). The door is unlocked by use of a pharmacist key. Hence, Lavigne does not disclose using a computer to unlock a lock.

Lavigne also does not disclose a computer operative responsive to input of an item indicia to output a signal changing the lock to the unlocked condition. Lavigne does not disclose using a computer, which responds to inputted data, to output a signal to change a lock from a locked condition to an unlocked condition. In Lavigne, the door (21) is unlocked by use of a pharmacist key, not by a computer. It follows that Lavigne's door (21) is not unlocked by a computer in response to inputted data.

Nothing in Lavigne compares identification information input by a user to data stored in a data store. The memory on the Lavigne carrier holds information corresponding to the person having possession of the carrier at any given time. However there is no disclosure in Lavigne

that the information input concerning the person having custody of the carrier is compared to a listing of “authorized users.”

Nothing in Lavigne discloses that a user is enabled to input indicia corresponding to a medical item responsive to the input of data corresponding to an authorized user in a data store.

Nothing in Lavigne discloses that a computer is operative responsive to an open signal to change a lock to a locked condition.

Pending Claim 46 Is Not Anticipated By Higham

As admitted by the Office, claim 45 is not anticipated by Higham. It follows that claim 46, which depends from claim 45, is also not anticipated by Higham. The previously discussed reasons why claim 45 (and hence claim 46) is not anticipated by Higham are incorporated by reference.

The action alleges that Higham shows a data store having user data representative of a plurality of authorized users at col. 13, lines 30-41. The Appellants disagree. There is no indication that Higham has a data store including user data representative of a plurality of authorized users. Nor is there any indication that Higham’s user identification information corresponds to data for an authorized user. Higham at col. 13, lines 32-33 states that user identification information and patient identification information are entered into a processor. It appears that this information is gathered for record keeping and not for authorized usage. Why would patient identification information be needed for authorizing use?

Nothing in Higham compares identification information input by a user to data stored in a data store. There is no disclosure in Higham that the entered information is compared to data representative of a plurality of “authorized users.”

Furthermore, nothing in Higham discloses that a user is enabled to input indicia corresponding to a medical item responsive to the input of data corresponding to an authorized user in a data store.

Furthermore, Higham does not disclose a lock having a visual indicator. The Action alleges that Higham has a lock that comprises a visual indicator at col. 11, lines 41-65. However, the referenced section of Higham is silent as to a lock having a visual indicator in the manner recited.

Nor does Higham disclose that a visual indicator provides an indication responsive to a computer output signal that a door is enabled to be opened. In Higham the visual indicators are used to indicate which drawer or rack has the item, and are then used to indicate the location of the item in that particular drawer or rack (col. 7, lines 1-6). Nothing in Higham discloses that a visual indicator provides an indication that a door is enabled to be opened.

The Pending Claims 46-47 Are Not Obvious Over Higham

The previously discussed reasons why claim 45 (and hence claims 46-47) is patentable over Higham are incorporated by reference.

Claim 46

The Action is silent as to why the features and relationships of claim 46 are obvious. Appellants’ arguments as to why claim 46 is not anticipated by Higham are herein incorporated

by reference. Furthermore, nothing in Higham discloses nor suggests the features and relationships that are specifically recited in the claim. Additionally, there is no teaching, suggestion, or motivation cited for combining features of Higham so as to produce Appellants' invention.

Claim 47

In claim 47 a computer is operative responsive to an open signal to change a lock to a locked condition, wherein when a door is next returned to a closed condition the door is held therein.

Higham does not disclose using a computer to change a lock from a locked to an unlocked condition. Higham also does not disclose a computer operative responsive to input of an item indicia to output a signal changing the lock to the unlocked condition.

Nothing in Higham discloses that a computer is operative responsive to an open signal (responsive to opening the door) to change a lock to a locked condition. It follows that Higham does not disclose that when an opened door is next returned to a closed condition the door is held therein.

There is no indication in Higham of the capability to change a lock to a locked condition. Nor does Higham have the capability to change a lock to a locked condition using a computer.

The Action alleges that it would have been obvious for Higham to lock the door upon closure. The Appellants disagree. Even if Higham's drawers were (automatically) locked "upon closure" as alleged they still would not be changed to a locked condition by a computer. Nor would the lock be changed to a locked condition operatively responsive to an open signal.

Higham is silent as to lock operation. It is unclear whether Higham has an electronically operated lock wherein the drawer is in a permanent locked state except for the brief time when it is permitted to be opened. Nevertheless, Higham does not disclose or suggest changing a lock to a locked condition by a using computer operative responsive to a door open signal.

Pending Claim 47 Is Not Obvious Over Lavigne In View of Aten

The previously discussed reasons why claim 45 (and hence claim 47) is patentable over both Lavigne and Lavigne in view of Aten are incorporated by reference. The previously discussed reasons why claim 47 is not anticipated by Lavigne are incorporated by reference.

The Action relies on Aten as allegedly teaching a permanent magnet. However, claim 26 recites a permanent magnet. The alleged permanent magnet feature is not found in claim 47.

The Action is unclear as to why Aten was applied to claim 47. The Action is silent as to how Aten relates to claim 47. Nor has the Action explained how the teachings of Aten could have been used to modify Lavigne to teach the recited features and relationships of claim 47.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion, or motivation in the references to produce Appellants' claimed features and relationships. Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. It is therefore respectfully submitted that this rejection should be withdrawn.

The Advisory Action

The Advisory Action briefly refers to *res judicata* in relation to claim 45. However, MPEP § 707.07(g) clearly states that where a major technical rejection (such as *res judicata*) is proper, “it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.” It is respectfully submitted that a full development of reasons has not been provided to Appellants, as is required. Hence, the Advisory Action’s brief mention of *res judicata* constitutes piecemeal examination and a legally insufficient basis for rejection.

Furthermore, it is respectfully submitted that if the Patent Office is in fact applying a *res judicata* type of rejection, then this type of rejection was first applied in the Advisory Action. Thus, because the *res judicata* type of rejection was first applied after the Final rejection, it constitutes an improper new ground of rejection.

Other Comments

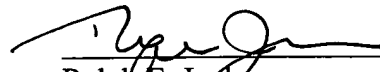
Appellants’ remarks in the amendments filed May 23, 2000 and September 27, 2000 in support of the patentability of the claims are incorporated by reference as if fully rewritten herein.

CONCLUSION

As explained above, many of the rejections are improper as they are not based on references which constitute prior art. Further, each of the pending claims specifically recite features, relationships, or steps that are neither disclosed nor suggested in any of the applied art.

Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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Reg. No. 31,029

APPENDIX

CLAIMS

1. A system for providing medical items comprising:

a computer, wherein the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored;

a user interface in operative connection with the computer, wherein the interface includes an input device;

a refrigerator, wherein a storage location for at least one medical item is stored in an interior area of the refrigerator, the refrigerator including a door, wherein access to the interior area is controlled by opening and closing the door;

a lock module operatively attached to the refrigerator, wherein the lock module is in operative connection with the computer, and wherein the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition, wherein in the locked condition the

refrigerator is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device, and wherein the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.

2. The system according to claim 1 and wherein the lock module further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the signal that the door is enabled to be opened .

3. The system according to claim 1 and wherein the lock module further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.

24. A system for providing medical items comprising:

a computer, wherein the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored;

a user interface in operative connection with the computer, wherein the interface includes an input device;

a preexisting housing structure, wherein a storage location for at least one medical item is stored in an interior area of the housing structure, the housing structure including a door, wherein access to the interior area is controlled by opening and closing the door.

a lock module mounted on an exterior surface of the housing structure, wherein the lock module is in operative connection with the computer, and wherein the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition, wherein in the locked condition the door is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device, and wherein the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.

25. The system according to claim 24 wherein the lock module further includes a door sensor in operative connection with the door and the computer, and a latching device wherein the latching device is operative to selectively maintain the lock module in the locked and unlocked conditions, wherein the latching device is operative to hold the lock module in the unlocked position responsive to the signal, and thereafter the computer is operative to cause the output of a further signal, wherein the further signal changes the lock module to a locked condition and thereafter the latching device holds the lock module in the locked condition, and wherein the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.

26. The system according to claim 25 wherein the latching device includes a permanent magnet latching solenoid.

45. A system for providing medical items comprising:

a computer, wherein the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored;

a user interface in operative connection with the computer, wherein the interface includes at least one input device;

a housing, wherein a storage location for at least one medical item is located in an interior area of the housing, the housing including a door, wherein access to the storage location is controlled by opening and closing the door;

a lock in operative connection with the housing, wherein the lock is in operative connection with the computer, and wherein the lock is operative responsive to at least one signal from the computer to change the lock from a locked to an unlocked condition, wherein in the locked condition the door is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.

46. The system according to claim 45 and wherein the lock further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the at least one signal that the door is enabled to be opened.

47. The system according to claim 45 and wherein the lock further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/086,857 05/29/98 FREDERICK

D D-1093

RALPH E. JOCKE
231 SOUTH BROADWAY
MEDINA OH 44256

PM92/0409

EXAMINER

BUTLER, M

ART UNIT	PAPER NUMBER
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3651

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DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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**Notification of Non-Compliance with
37 CFR 1.192(c)**

Application No.
09/086,857

Applicant(s)
Frederick et al.

Examiner
Michael E. Butler

Group Art Unit
3651



The Appeal Brief filed on Jan 11, 2001 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

Applicant is given a TIME LIMIT of ONE MONTH from the date of this letter or any time remaining in the period under 37 CFR 1.192(a) for filing a new complete brief. If a new brief that fully complies with 37 CFR 1.192(c) is not timely submitted, the appeal will be dismissed. The new complete brief must be filed IN TRIPLICATE. See 37 CFR 1.192(a).

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - a. ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - b. ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☒ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

Explanation in detailed action.

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

Art Unit: 3651

DETAILED ACTION***Defective Appeal Brief***

1. The appellant's 89 page "Brief" is defective for exceeding the principal brief size limit without receiving special leave from the Board to file an oversized "brief." The Federal Rules (of Appellate Procedure) provide a safe harbor limit for principal briefs of 30 pages. FED. R. APP. P. 32 (7)(A); 28 U.S.C. Appendix. Alternately, appellants may certify brief volume to a maximum of 14,000 words or 1300 lines with a monofaced type. FED. R. APP. P. 32 (7)(B & C); 28 U.S.C. Appendix. As a further alternative, the party may obtain special leave from the adjudicator. FED. R. APP. P. 32, *Judicial Advisory Committee Annotations on Rule 32*.

The Administrative Procedures Act proscribes that unless a statute on point or an agency promulgated rule on point exists, the [Federal] Rules of Evidence and Procedure apply, 5 U.S.C. § 559. The United States Patent and Trademark Office is an administrative agency within the context of the Administrative Procedures Act, *Dickenson vs. Zurko*, 50 USPQ2d 1930, 1933; 527 U.S. 150 (1999). In his majority opinion, Justice Breyer held that § 559 generates uniform standards among the agencies. *Dickenson vs. Zurko* at 1935.

By way of example, a rule on point expressly superceding § 559 is the express page limit for briefs filed before the Trademark Trial and Appeal Board. 37 CFR § 2.128(b). Statutes superceding § 559 include other portions of the Administrative Procedures Act such as the standard of review expressly proscribed in 5 U.S.C. § 706 wherein the § 706 standard of review superceded implementation of Rule 52(A) as triggered via § 559. *Dickenson vs. Zurko* at 1932. There is no statutory limit within Titles 35 or 5 of the Code or Title 37 of the Rules on brief size before the Board of Patent Appeals and Interferences. As there is no express rule or statute on

Art Unit: 3651

point limiting brief size, the 30 page safe harbor limit of Rule 32 applies unless a party is granted permission via special leave from the Board upon exercise of the Board's discretionary authority or unless party elects to certify volume as expressed in word count or line count.

When a party generates an oversized brief, he unduly burdens the adjudicator with excessive analysis and obscures the focus of the issues they need analyze and decide, thereby making the task of the adjudicator (in this instance, the Board) more difficult. As such, a party needs obtain permission from the adjudicator when burdening it with such an extra workload. Since applicant failed to obtain leave from the Board of Patent Appeals and Interferences for the filing of an oversized brief, applicant's 89 page brief is defective.

As noted in the included annotated sections, the Judicial Advisory Committee wrote Rule 32(7) with its 14,000 word/1300 line limitations, toward a goal of proximating Rule 32 in word content with the 50 page limit of old Rule 28(G) of which it was replacing. Rule 28(G) was written at a time when briefs were generated on typewriters.

As a courtesy to applicant, the examiner includes for applicant's benefit the article warning that briefs certified with MS Word® may give erroneous word counts if the factory default options are not properly deselected-held to be inexcusable attorney misrepresentation.

2. Applicant has misstated the status of claims 46-47 with respect to rejections evidenced in whole or part by Higham et al. or Lavigne as having been withdrawn by the examiner. Only the rejections of claim 45 as evidenced by Higham et al., the 102 rejection evidenced by Lavigne to claim 45, and the 103 rejection evidenced by Lavigne in view of Aten to claim 45 were withdrawn by the examiner. No rejections on claims 46 or 47 were withdrawn. In accord with 37 CFR 1.192 (8) (iii and iv) and MPEP § 1206, applicant's brief is defective. If applicant's intent is to concede these rejections, he need not address these rejections.

Art Unit: 3651

Conclusion

3. Appellant is required to comply with provisions of 37 CFR 1.192(c) and Rule 32.

To avoid dismissal of the appeal, Appellant must comply within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis, can be reached on (703) 308-2560. The fax number for the Group is (703) 305-7687.

Michael E. Butler

Michael E. Butler
Examiner

CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Notice of References Cited		Application No. 09/086,857		Applicant(s) Frederick et al.	
		Examiner Michael E. Butler		Group Art Unit 3651	Page 1 of 1

U.S. PATENT DOCUMENTS						
	DOCUMENT NO.	DATE	NAME		CLASS	SUBCLASS
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NON-PATENT DOCUMENTS		
	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U	Lea, Graham, Avoid MS Word, US appellate judges warn lawyers, The Register, 2/8/99	2/1999
V	Federal Rules of Appellate Procedure Rule 32, 28 U.S.C.A. appendix	2000
W		2/1999
X		

***40074 Federal Rules of Appellate Procedure
Rule 32, 28 U.S.C.A.**

**UNITED STATES CODE
ANNOTATED
FEDERAL RULES OF
APPELLATE PROCEDURE
TITLE VII GENERAL
PROVISIONS**

Rules amendments received to 6-19-2000

**Rule 32. Form of Briefs, Appendices, and
Other Papers**

(a) Form of a Brief.

(1) Reproduction.

(A) A brief may be reproduced by any process that yields a clear black image on light paper. The paper must be opaque and unglazed. Only one side of the paper may be used.

(B) Text must be reproduced with a clarity that equals or exceeds the output of a laser printer.

(C) Photographs, illustrations, and tables may be reproduced by any method that results in a good copy of the original; a glossy finish is acceptable if the original is glossy.

(2) Cover. Except for filings by unrepresented parties, the cover of the appellant's brief must be blue; the appellee's, red; an intervenor's or amicus curiae's, green; and any reply brief, gray. The front cover of a brief must contain:

(A) the number of the case centered at the top;

(B) the name of the court;

(C) the title of the case (see Rule 12(a));

(D) the nature of the proceeding (e.g., Appeal, Petition for Review) and the name of the court, agency, or board below;

(E) the title of the brief, identifying the party or parties for whom the brief is filed; and

(F) the name, office address, and telephone number of counsel representing the party for whom the brief is filed.

(3) Binding. The brief must be bound in any manner that is secure, does not obscure the text, and permits the brief to lie reasonably flat when open.

(4) Paper Size, Line Spacing, and Margins. The brief must be on 8 1/2 by 11 inch paper. The text must be double-spaced, but quotations more than two lines long may be indented and single-spaced. Headings and footnotes may be single-spaced. Margins must be at least one inch on all four sides. Page numbers may be placed in the margins, but no text may appear there.

*40075 (5) Typeface. Either a proportionally spaced or a monospaced face may be used.

(A) A proportionally spaced face must include serifs, but sans-serif type may be used in headings and captions. A proportionally spaced face must be 14-point or larger.

(B) A monospaced face may not contain more than 10 1/2 characters per inch.

(6) Type Styles. A brief must be set in a plain, roman style, although italics or boldface may be used for emphasis. Case names must be italicized or underlined.

(7) Length.

(A) Page limitation. A principal brief may not exceed 30 pages, or a reply brief 15 pages, unless it complies with Rule 32(a)(7)(B) and (C).

(B) Type-volume limitation.

(i) A principal brief is acceptable if:
· it contains no more than 14,000 words; or

· it uses a monospaced face and contains no more than 1,300 lines of text.

(ii) A reply brief is acceptable if it contains no more than half of the type volume specified in Rule 32(a)(7)(B)(i).

(iii) Headings, footnotes, and quotations count toward the word and line limitations. The corporate disclosure statement, table of contents, table of citations, statement with respect to oral argument, any addendum containing statutes, rules or regulations, and any certificates of counsel do not count toward the limitation.

(C) Certificate of compliance. A brief submitted under Rule 32(a)(7)(B) must include

a certificate by the attorney, or an unrepresented party, that the brief complies with the type-volume limitation. The person preparing the certificate may rely on the word or line count of the word-processing system used to prepare the brief. The certificate must state either:

- (i) the number of words in the brief;
- or
- (ii) the number of lines of monospaced type in the brief.

(b) Form of an Appendix. An appendix must comply with Rule 32(a)(1), (2), (3), and (4), with the following exceptions:

(1) The cover of a separately bound appendix must be white.

*40076 (2) An appendix may include a legible photocopy of any document found in the record or of a printed judicial or agency decision.

(3) When necessary to facilitate inclusion of odd-sized documents such as technical drawings, an appendix may be a size other than 8 1/2 by 11 inches, and need not lie reasonably flat when opened.

(c) Form of Other Papers.

(1) Motion. The form of a motion is governed by Rule 27(d).

(2) Other Papers. Any other paper, including a petition for rehearing and a petition for rehearing en banc, and any response to such a petition, must be reproduced in the manner prescribed by Rule 32(a), with the following exceptions:

(A) a cover is not necessary if the caption and signature page of the paper together contain the information required by Rule 32(a)(2); and

(B) Rule 32(a)(7) does not apply.

(d) Local Variation. Every court of appeals must accept documents that comply with the form requirements of this rule. By local rule or order in a particular case a court of appeals may accept documents that do not meet all of the form requirements of this rule.

CREDIT(S)

2000 Electronic Update

(As amended Apr. 24, 1998, eff. Dec. 1, 1998.)

<General Materials (GM) - References, Annotations, or Tables>

HISTORICAL NOTES

ADVISORY COMMITTEE NOTES

1967 Adoption

Only two methods of printing are now generally recognized by the circuits—standard typographic printing and the offset duplicating process (multilith). A third, mimeographing, is permitted in the Fifth Circuit. The District of Columbia, Ninth, and Tenth Circuits permit records to be reproduced by copying processes. The Committee feels that recent and impending advances in the arts of duplicating and copying warrant experimentation with less costly forms of reproduction than those now generally authorized. The proposed rule permits, in effect, the use of any process other than the carbon copy process which produces a clean, readable page. What constitutes such is left in first instance to the parties and ultimately to the court to determine. The final sentence of the first paragraph of subdivision (a) is added to allow the use of multilith, mimeograph, or other forms of copies of the reporter's original transcript whenever such are available.

*40077 1998 Amendments

In addition to amending Rule 32 to conform to uniform drafting standards, several substantive amendments are made. The Advisory Committee had been working on substantive amendments to Rule 32 for some time prior to completion of this larger project.

Subdivision (a). Form of a Brief.

Paragraph (a)(1). Reproduction.

The rule permits the use of "light" paper, not just "white" paper. Cream and buff colored paper, including recycled paper, are acceptable. The rule permits printing on only one side of the paper. Although some argue that paper could be saved by allowing double-sided printing, others argue that in order to preserve legibility a heavier weight paper would be needed, resulting in little, if any, paper saving. In addition, the blank sides of a brief are commonly used by judges and their clerks for making notes about the case.

Because photocopying is inexpensive and widely available and because use of carbon paper is now very rare, all references to the use of carbon copies have been deleted.

The rule requires that the text be reproduced with a clarity that equals or exceeds the output of a laser printer. That means that the method used must have a print resolution of 300 dots per inch (dpi) or more. This will ensure the legibility of the brief. A brief produced by a typewriter or a daisy wheel printer, as well as one produced by a laser printer, has a print resolution of 300 dpi or more. But a brief

produced by a dot-matrix printer, fax machine, or portable printer that uses head or dye to transfer methods does not. Some ink jet printers are 300 dpi or more, but some are 216 dpi and would not be sufficient.

Photographs, illustrations, and tables may be reproduced by any method that results in a good copy.

Paragraph (a)(2). Cover.

The rule requires that the number of the case be centered at the top of the front cover of a brief. This will aid in identification of the brief. The idea was drawn from a local rule. The rule also requires that the title of the brief identify the party or parties on whose behalf the brief is filed. When there are multiple appellants or appellees, the information is necessary to the court. If, however, the brief is filed on behalf of all appellants or appellees, it may so indicate. Further, it may be possible to identify the class of parties on whose behalf the brief is filed. Otherwise, it may be necessary to name each party. The rule also requires that attorneys' telephone numbers appear on the front cover of a brief or appendix.

*40078 Paragraph (a)(3). Binding.

The rule requires a brief to be bound in any manner that is secure, does not obscure the text, and that permits the brief to lie reasonable flat when open. Many judges and most court employees do much of their work at computer keyboards and a brief that lies flat when open is significantly more convenient. One circuit already has such a requirement and another states a preference for it. While a spiral binding would comply with this requirement, it is not intended to be the exclusive method of binding. Stapling a brief at the upper left-hand corner also satisfies this requirement as long as it is sufficiently secure.

Paragraph (a)(4). Paper Size, Line Spacing, and Margins.

The provisions for pamphlet-size briefs are deleted because their use is so rare. If a circuit wishes to authorize their use, it has authority to do so under subdivision (d) of this rule.

Paragraph (a)(5). Typeface.

This paragraph and the next one, governing type style, are new. The existing rule simply states that a brief produced by the standard typographic process must be printed in at least 11 point type, or if produced in any other manner, the lines of text must be double spaced. Today few briefs are produced by commercial printers or by typewriters; most are produced on and printed by computer. The availability of computer fonts in a variety of sizes and styles has given rise to local rules limiting type styles. The Advisory Committee believes that some standards are needed both to ensure that all litigants have an equal opportunity to present their material and to ensure that the briefs are easily legible.

With regard to typeface there are two options;

proportionally-spaced typeface or monospaced typeface.

A proportionally-spaced typeface gives a different amount of horizontal space to characters depending upon the width of the character. A capital "M" is given more horizontal space than a lower case "i". The rule requires that a proportionally-spaced typeface have serifs. Serifs are small horizontal or vertical strokes at the ends of the lines that make up the letters and numbers. Studies have shown that long passages of serif type are easier to read and comprehend than long passages of sans-serif type. The rule accordingly limits the principal sections of submissions to serif type although sans-serif type may be used in headings and captions. This is the same approach magazines, newspapers, and commercial printers take. Look at a professionally printed brief; you will find sans-serif type confined to captions, if it is used at all. The next line shows two characters enlarged for detail. The first has serifs, the second does not.

*40079 Y Y *

[* For original representation of characters, see House Document 105-269 of the 105th Congress, 2d Session dated May 11, 1998 entitled "Amendments to the Federal Rules of Appellate Procedure (Executive Communication No. 9072)."]

So that the type is easily legible, the rule requires a minimum type size of 14 points for proportionally-spaced typeface.

A monospaced typeface is one in which all characters have the same advance width. That means that each character is given the same horizontal space on the line. A wide letter such as a capital "M" and a narrow letter such as a lower case "i" are given the same space. Most typewriters produce mono-spaced type, and most computers also can do so using fonts with names such as "Courier."

This sentence is in a proportionally spaced font; as you can see, the m and i have different widths. *

[* For original representation of characters, see House Document 105-269 of the 105th Congress, 2d Session dated May 11, 1998 entitled "Amendments to the Federal Rules of Appellate Procedure (Executive Communication No. 9072)."]

This sentence is in a monospaced font; as you can see, the m and i have the same width. *

[* For original representation of characters, see House Document 105-269 of the 105th Congress, 2d Session dated May 11, 1998 entitled "Amendments to the Federal Rules of Appellate Procedure (Executive Communication No. 9072)."]

The rule requires use of a monospaced typeface that produces no more than 10 1/2 characters per inch. A standard typewriter with pica type produces a monospaced typeface with 10 characters per inch (cpi). That is the ideal monospaced typeface. The rule permits up to 10 1/2 cpi because some computer software programs contain monospaced fonts that purport to produce 10 cpi but that in

fact produce slightly more than 10 cpi. In order to avoid the need to reprint a brief produced in good faith reliance upon such a program, the rule permits a bit of leeway. A monospaced typeface with no more than 10 cpi is preferred.

Paragraph (a)(6). Type Styles.

*40080 The rule requires use of plain roman, that is not italic or script, type. Italics and boldface may be used for emphasis. Italicizing case names is preferred but underlining may be used.

Paragraph (a)(7). Type-Volume Limitation.

Subparagraph (a)(7)(A) contains a safe-harbor provision. A principal brief that does not exceed 30 pages complies with the type-volume limitation without further question or certification. A reply brief that does not exceed 15 pages is similarly treated. The current limit is 50 pages but that limit was established when most briefs were produced on typewriters. The widespread use of personal computers has made a multitude of printing options available to practitioners. Use of a proportional typeface alone can greatly increase the amount of material per page as compared with use of a monospaced typeface. Even though the rule requires use of 14-point proportional type, there is great variation in the x-height of different 14-point typefaces. Selection of a typeface with a small x-height increases the amount of text per page. Computers also make possible fine gradations in spacing between lines and tight tracking between letters and words. All of this, and more, have made the 50-page limit virtually meaningless. Establishing a safe-harbor of 50 pages would permit a person who makes use of the multitude of printing "tricks" available with most personal computers to file a brief far longer than the "old" 50-page brief. Therefore, as to those briefs not subject to any other volume control than a page limit, a 30-page limit is imposed.

The limits in subparagraph (B) approximate the current 50-page limit and compliance with them is easy even for a person without a personal computer. The aim of these provisions is to create a level playing field. The rule gives every party an equal opportunity to make arguments, without permitting those with the best in-house typesetting an opportunity to expand their submissions.

The length can be determined either by counting words or lines. That is, the length of a brief is determined not by the number of pages but by the number of words or lines in the brief. This gives every party the same opportunity to present an argument without regard to the typeface used and eliminates any incentive to use footnotes or typographical "tricks" to squeeze more material onto a page.

The word counting method can be used with any typeface.

*40081 A monospaced brief can meet the volume limitation by using the word or a line count. If the line counting method is used, the number of lines may not exceed 1,300—26 lines per page in a 50-page brief. The number of lines is easily counted manually. Line counting is not sufficient if a

proportionally spaced typeface is used, because the amount of material per line can vary widely.

A brief using the type-volume limitations in subparagraph (B) must include a certificate by the attorney, or party proceeding pro se, that the brief complies with the limitation. The rule permits the person preparing the certification to rely upon the word or line count of the word-processing system used to prepare the brief.

Currently, Rule 28(g) governs the length of a brief. Rule 28(g) begins with the words "[e]xcept by permission of the court," signaling that a party may file a motion to exceed the limits established in the rule. The absence of similar language in Rule 32 does not mean that the Advisory Committee intends to prohibit motions to deviate from the requirements of the rule. The Advisory Committee does not believe that any such language is needed to authorize such a motion.

Subdivision (b). Form of an Appendix.

The provisions governing the form of a brief generally apply to an appendix. The rule recognizes, however, that an appendix is usually produced by photocopying existing documents. The rule requires that the photocopies be legible.

The rule permits inclusion not only of documents from the record but also copies of a printed judicial or agency decision. If a decision that is part of the record in the case has been published, it is helpful to provide a copy of the published decision in place of a copy of the decision from the record.

Subdivision (c). Form of Other Papers.

The old rule required a petition for rehearing to be produced in the same manner as a brief or appendix. The new rule also requires that a petition for rehearing en banc and a response to either a petition for panel rehearing or a petition for rehearing en banc be prepared in the same manner. But the length limitations of paragraph (a)(7) do not apply to those documents and a cover is not required if all the information needed by the court to properly identify the document and the parties is included in the caption or signature page.

Existing subdivision (b) states that other papers may be produced in like manner, or "they may be typewritten upon opaque, unglazed paper 8 1/2 by 11 inches in size." The quoted language is deleted but that method of preparing documents is not eliminated because (a)(5)(b) permits use of standard pica type. The only change is that the new rule now specifies margins for typewritten documents.

*40082 Subdivision (d). Local Variation.

A brief that complies with the national rule should be acceptable in every court. Local rules may move in one direction only; they may authorize noncompliance with certain of the national norms. For example, a court that wishes to do so may authorize printing of briefs on both sides of the paper, or the use of smaller type size or sans-serif

proportional type. A local rules may not, however, impose requirements that are not in the national rule.

REFERENCES

CROSS REFERENCES

Typewritten briefs, appendices, and other papers allowed in forma pauperis, see Federal Rules of Appellate Procedure Rule 24, 28 USCA.

LIBRARY REFERENCES

American Digest System

Form of briefs, appendix and other papers, see Federal Courts ¶691 to 716.

Encyclopedias

Form of briefs, appendix and other papers, see C.J.S. Federal Courts §§ 295(12), 296(14).

Forms

Cover for brief, see West's Federal Forms § 796 and Comment thereunder.

Cover of brief, see West's Federal Forms § 796.

2 Federal Procedural Forms L Ed, Appeal, Certiorari, and Review §§ 3:52, 3:53, 3:112, 3:113, 3:257, 3:483, 3:489, 3:490, 3:492-3:495, 3:505, 3:507, 3:513, 3:528, 3:593

2 Fed Procedural Forms L Ed, Appeal, Certiorari, and Review §§ 3:174, 674, 715, 716, 722, 729, 743, 751-753, 774,

942

16 Federal Procedural Forms L Ed, Trade Regulations and Unfair Trade Practices § 65:54

Law Review and Journal Commentaries

Federal rehearing and certiorari practice. Dennis J.C. Owens, 44 J.Mo.B. 495 (1988).

Texts and Treatises

Form of briefs, etc., see Wright, Miller, Cooper & Gressman, Federal Practice and Procedure: Jurisdiction § 3978.

Appeal, Certiorari, and Review, Fed Proc, L Ed, §§ 3:549, 3:556, 3:573-3:576, 3:740

2A Fed Proc L Ed, Appeal, Certiorari, and Review (1994) §§ 3:604, 611, 630-633, 639, 835, 836

*40083 Bankruptcy, Fed Proc, L Ed, §§ 9:772, 9:782

ANNOTATIONS

NOTES OF DECISIONS

Costs 4

Financial hardship 3

Standard typographic printing 1

Typewritten briefs 2

1. Standard typographic printing

Litigant could not be faulted for using standard typographic printing for reproducing parts of record in joint appendix, an approved method of reproducing. *Oliver v. Michigan State Bd. of Ed.*, C.A.6 (Mich.) 1975, 519 F.2d 619.

2. Typewritten briefs

Failure to comply with rule governing form of appellate briefs warranted imposition of sanction on appellant's counsel, where lines in appellant's opening brief were not double-spaced, but rather spaced only one-and-one-half spaces apart, and footnotes in both opening and reply brief violated rule. *Kano v. National Consumer Co-op. Bank*, C.A.9 1994, 22 F.3d 899.

Where good cause appeared, movant's motion to proceed on typewritten briefs on appeal in habeas corpus proceeding was granted. *Fleish v. Swope*, C.A.9 1955, 221 F.2d 558.

3. Financial hardship

Relief from requirement of printing appendix is freely granted those financially burdened by fulfilling requirements of printing. *Arnold Productions, Inc. v. Favorite Films Corp.*, C.A.2 (N.Y.) 1961, 291 F.2d 94.

4. Costs

Assessment of double costs against appellants was appropriate where appellants filed overly long brief, although brief was less than 50 pages, it was not double spaced as required and thus was effectively considerably longer than regulatory requirement, and despite extra length, it failed to adequately present claims or clearly identify claims being appealed. *Doyle v. Hasbro, Inc.*, C.A.1 (Mass.) 1996, 103 F.3d 186.

Where brief of the appellees was not in conformity with former court rule as to form, the appellees would be denied recovery of their costs on appeal. *Utility Service Corp. v. Hillman Transp. Co.*, C.A.3 (Pa.) 1957, 244 F.2d 121.

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Avoid MS Word, US appellate judges warn lawyers

By Graham Lea

Posted: 02/08/1999 at 16:26 GMT

MS Word has been condemned by three US Court of Appeals judges for giving an incorrect word count. Rule 32 of the appeal procedure requires briefs to be no more than 14,000 words (and reply briefs 7000 words), but the hapless party to an otherwise irrelevant case in the Northern District of Illinois was castigated for a false certificate to the court that a brief was 13,824 words long. Rule 32 says that headings, footnotes, quotations etc. count toward the word and line limitations. It turned out there were 15,056 words according to WordPerfect. The faulty product was MS Word 97, which has an option to include footnotes if invoked – except that it is dimmed and cannot be used if any text is selected, so the count is for the number of words excluding footnotes. This is a problem because the corporate disclosure statement, the table of contents, the table of citations, and the like do not count towards the word limit, so selecting text is essential. It's a bug, of course, although we shall probably be told it is a feature. The judges said: "Current versions of Corel WordPerfect (for both Windows and Macintosh platforms) do not have this problem. WordPerfect does what lawyers may suppose that Word does (or should do): it automatically includes footnotes in its word and character counts." The endorsement of WP continued: "Lawyers who produce their documents with WordPerfect software have an easy job of things under Rule 32." So far as the future is concerned, "Long-run solutions to this problem [Ha! Claiming it's a "feature" and not a "problem" could be contempt of court] must come either from Microsoft Corporation – which ought to make it possible to obtain a count of words in footnotes attached to a selected text... We will send copies of this Opinion to those responsible... flag this issue in the court's Practitioner's Guide... law firms should alert their staffs to the issue... our clerk's office will spot-check briefs that have been prepared on Microsoft Word." The Opinion concluded: "Counsel who use Word are not entitled to a litigating advantage over those who use WordPerfect." Quite. They deserve our sympathy,

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though. No wonder Sullivan & Cromwell, Microsoft's lawyers', us WordPerfect: they knew all along that they's have a lot of words to count for the Court of Appeals, and didn't want to look any sillier than necessary. ®

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